



INTELLECTUAL PROPERTY PROTECTION TO TRADEMARKS : LAW AND JUDICIAL TRENDS

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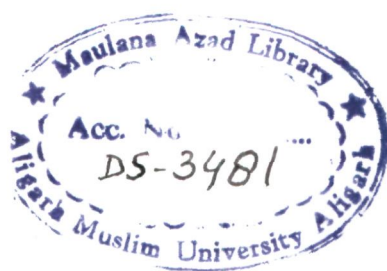
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Dedicated
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Certificate

It gives me pleasure to certify that **Mr. Kausar Ali**, student of LL.M. (Final), Roll No.01 LL.M-05 has completed his dissertation entitled "**Intellectual Property Protection to Trademarks: Law and Judicial Trends**" in partial fulfilment of the requirements for the award of the degree of Master of Laws. He has completed his dissertation under my supervision.

I wish him all success in life.


(Dr. Zaheeruddin)

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Abbreviation

ACA	- Australian Customs Authority
CBD	- Convention on Biological Diversity
CMI	- Copyrights Management Information
CPT	- Copy Protection Technique
DRM	- Digital Rights Managements
DRP	- Design Dispute Resolution Policy
EC	- European Community
EDV	- Essentially Derived Variety
EPA	- Environment Protection Act
GATT	- General Agreement on Tariffs and Trade
ICANN	- Internet Corporation for Assigned Names and Order
ICD	- Information and Communication Technology
IPR	- Intellectual Property Rights
ISPs	- Internets Service Provides
MTN	- Multilateral Trade Negotiations
NAFTA	- The North-American Free Trade Agreement
NICs	- Newly Industrialized Countries

PGR	- Plant Genetic Resources
PPVFR	- Protection of Plant Varieties and Farmer's Rights Act.
RDNH	- Reverse Domain Name Hijacking
SD	- Sub Domain
SLD	- Second Level Domain
TLD	- Top Level Domain
TRIPS	- Trade Related to Aspects of Intellectual Property Rights
UDRP	- Uniform Domain Name Dispute Resolution Policy
UPOV	- Union for the Protection of Plant Varieties
WIPO	- World Intellectual Property Organization
WTO	- World Trade Organisation

TABLE OF CASES

1. Aquafina Minerals Tech v/s Promode Borsel and others, 2001.
2. kalyanpuri Flour Mills (P) ltd v/s Tirupati \$Rollen Flower Mills, 2004 (28) PTC 322.
3. yahoo! Inc v/s Askahs Arora, 1999 (2) AD (Del) 229.
4. Honda Motor Company v/s Lokitia Enterprises, 2004, 28 PTC 332.
5. Dabour India Limited v/s Colgate Palmolive India Ltd. 2004 (29) PTC 401 (Del).
6. Reckitt and Coleman of India Ltd v/s Kiwi T.T.K. Ltd., 1996 (16) 393.
7. Reckitt and Coleman of India Ltd v/s Ramchandaran & Another 1999 PTC (19) 741.
8. Dabur India v/s Emami Limited in 2004 (SCOS).
9. Pepsi Co. Inc and Other Hindustan Coca Cola Ltd and Others 2003 (37) PTC 305.
10. Marks & Spencor PLC v/s One in a million 1998 FSR 205 (Ch. 1997).
11. Rediff Communication Ltd. Cyberbooth AIR 2000 Bombay 27.

12. Parker knoll v/s Knool International, 1962 RPC (HL) Per Lord Develin.
13. Tintan Industries v/s Prashant Koorapti and others.
14. Bhagwandas Chaman Lal v/s Shulton Inc. and other 2005(3) PTC 88.
15. Ceturiam Industrial Alliance v/s Gillette Liked 1998 PTC 288, Bombay.
16. Dhirpool and Company and Anothers v/s MR Dongree 1996 PTC 415, Delhi.
17. Bata Indian Ltd. V/s Deputy Registrar of Trademarks and Others 2004 (4) PTC 468.
18. Wander Ltd. And Another v/s Antox India P. Ltd. 1990 SHPP. SCC 727.
19. Jacques Jaunet S.A. v/s Newman and Other 2004 (29) PTC 747 (IPAB).
20. Panvision International v/s Toeppen 938, SPP. 616 (CD CAL 1996).
21. In Marks & Spencer PLC Vs One in a million 1998, FSR 265 (EH, 1997).

Introduction

Intellectual property was a fancy and rarely used word few years ago but the same has assumed a great importance in today's competitive business world. I.P. is also a quite debatable and politically delicate issue particularly in India. It has come into limelight during the discussion of Uruguay round of GATT in the year 1993-94.

As a signatory to the GATT which is now replaced by World Trade Organisation (W.T.O.) where the developed countries succeeded in inserting a chapter on intellectual property titled in 'Trade Related aspects of Intellectual Property Right', well known by its nick name "TRIPS". Since then the word Intellectual Property Rights has become a buzz word in the business and industry. In fact IP is a legal "instrument" for growth and industrialization. After the globalization of the Indian economy, the importance of intellectual property right has increased, more particularly due to the in flow of MNCs in India who possess and put emphasis on Intellectual Properties Rights (IPR). Recently IPR have acquired very an important place in the field of business & economy. We can say that none of the business of today, either small or large is without a touch of the Intellectual Property Rights (IPRs).

Intellectual Property Right broadly means a legal rights which result from intellectual creativity in the field of industrial, scientific,

artistic and literacy. Now we can say that IPR refers to a the use of bundle of legal doctrines which regulate the use of information, in the form of ideas, expression etc. We can say that in another words intellectual property can be regarded a single generic term that protects ideas special symbol, design, information and their application that are of the commercial value. Intellectual property includes copyright, trademarks, designs, geographical indications, layout-designs (topographic) of the integrated circuits, protection of undisclosed information (confidential information). In trade secrets etc conform legal exclusivity to the holder in the market place.

Intellectual property is nothing but legal concept of ownership applied to intangibles. We can say that intellectual property deals with intangible interest that carry social values. They are not confined to the art literature or in the area of technology. They also cover commercial interests and protect against unfair competition. It is not a properly right (as is understood for tangible) but monopoly rights limited and time and space. IPR are a statutory rights, which are territorial in nature and negative in their ambit, excluding, others thereby from exploiting or encroaching upon these rights.

Generally, all the countries have their own set of law to protecting these works. These works are considered it as a "intellectual property" as the same is created with skill, labour and

intellect of human being. It is obvious that no one would like to disclose or allow others copy a work which is a result of one's labour, intellect and money. It is therefore necessary to give a legal recognition to these endeavours in as much as the one can have legal titled for the land. But such "monopoly" rights are granted perpetually or a limited period. The records and documents that protects intellectual property owners rights contains valuable information much of its available to the public which is useful in many ways.

Loosely defined, intellectual property is a "product of mind." It is similar to any property consisting of movable or immovable things wherein the proprietor or owner may use his property as he wishes and nobody else can lawfully use his property without his permission.

Broadly speaking, IPRs, are divided into two categories; firstly, patents, design, trademarks, trade secrets, geographical indications, plant varieties rights integrated circuits, which are known as Industrial property, and secondly the copyrights and related or neighbouring rights and collectively known as intellectual property. It is possible that one may be the owner of one or more rights separately or jointly. It is also interesting to note that all these rights are known as "Intellectual Property Rights", each rights has its unique and different

purpose, different laws protecting different intangible, assets viz. patents for inventions, trademarks for brands.

Designs for aesthetic designs, Copyrights for literary, dramatic, musical and artistic work to name in few.

In India, intellectual property falls in the Union list of the seventh schedule under the article 246 of the constitution, which has itemized same as patents, inventions and designs, copy right trade marks and merchandise marks” (Item 49). From the nature of item brought together the framer of the Indian Constitution has apparently intended to afford protection, incentive and encouragement to artists men of letters, inventors, and the like limited monopoly is provided by patent Act 1970¹, the copyright Act 1957². The trademark Act 1999 read with trademark Rules 2001 in force with an effect from 15.2.2003 etc. balancing the right of the owner, inventors/creators of IPR and public interests.

In case of developing countries several recent reports by international agencies have reflected on the likely of the globalization of intellectual property protection on developing countries which may result into heavy cost, but with less perceivable benefits for them.

¹ The patent Act 1970 is amended by patent amendment Act 2003 alongwith its patents rules 2003 in from with effect from 20.5.2003.

² The copyright Act, 1957 as amended up 1999.

The owner can best protect his property if he keeps it out of the eyes and knowledge of the world. But in this situation the progress of the national will be hampered and also the owner of the property will not be in a position to use his property at his will. Therefore, appropriate national legislations govern the Intellectual Property Rights (IPRS).

The national legislations specifically describe the inventions, which are the subject matter of protection and those, which are excluded from the protection. For example, methods of treatment of the humans or animals by surgery or therapy and inventions whose use would be contrary to the law or morality; or inventions, injurious to public health are excluded from patentability in the Indian legislation.

The importance of a trademark in respect of goods and services hardly needs any emphasis considering the fact that a trademark is a sign which serves to distinguish the goods or services of an industrial or commercial enterprise from those of any other enterprise. A trademark is a means of identification which enables the traders to make their goods or services readily distinguishable from similar goods or services being supplied by or provided by other.

A trademark may consist of one or more distinguishable words, letters, numbers, drawings or pictures, emblems, colours or combination of colours etc. The mark may also consist of a

combination of one or more of the said elements. A trademark is a commercial asset intended for commercial usage and the owner thereof gets a perpetual rights to its exclusive usage in relation to goods and services. In India the, Trade & Merchandise Marks Act of 1958 was replaced by the Trade Marks Act of 1999 making drastic changes so as to conform to the international standards on the law and also to include within its fold service marks. The said Act provides for the registration of trade marks in relation to particular goods and services and provides for the action (civil as well as criminal) against infringement of such trade marks. The Act also contains provisions to facilitate civil action for passing off i.e. where an unregistered trademark is flouted.

The emergence of internet or the onset of the 'e' or 'electronic culture' has led to a radical metamorphosis in the manner a business can reach out to its customers. Information about a particular product or a reputed brand name is easily accessible through the powerful search engines available on the internet. While before the emergence of the e-culture, business entities had acquired intellectual property rights viz. trade marks in their products through continuous promotion of the particular brand name by means of advertising through the media viz. the press, television, radio broadcasts and other means, the development of the internet has opened new vistas for a very effective brand promotion for the internet users who are in fact

increasing leaps and bounds with the awareness of the electronic culture. It is not difficult to find cybercafes even in the remote areas of the country and computer with internet access is becoming more of a necessity than a luxury. This factor has also opened the pandora's box on the aspect of intellectual rights in the domain names and their conflicts vis a vis the registered trade marks. A domain name means the address of a business entity on the internet or cyberspace or a references for having access to the business credentials of a 'entity. Domain names are made available by the Registering Authorities on application. The importance of domain names on a similar footing with trade marks is now legally recognized.

A conflict situation arises typically when a company having an established brand name and registered trade mark approaches the registering authority for registration of the domain name on the internet so as to guide its potential customers to the site where more details about its products and services can be provided. In all probability, the domain name chosen by such a company has to be its reputed brand name or the registered trade mark for eg :- Microsoft Inc would definitely seek a domain name microsoftcom or Cadbury's Ltd. would definitely seek the domain name cadbury's.com because potential customers are familiar with the brand name viz Microsoft or Cadbury's.

However, there is a possibility that some innocuous entity has already registered the domain name using the established trade mark and owing to the strict rules of the registering authorities not to allow the same domain name the company seeking the domain name in the name of its trade mark has to contend itself with an identical domain name but not the exact name as its trade mark. It has also been observed in all such cases that the innocuous entity seeks a hefty compensation from the company for transfer of the domain name and this practice has come to be known as 'cybersquatting'.

The basic rule contained in the Agreement is that any sign, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually perceptible. Such signs, in particular - words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs must be eligible for registration as trademarks.

The Agreement requires service marks to be protected in the same way as marks distinguishing goods. The owner of a registered trademark must be granted the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade, identical or similar signs for goods or service which are

identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion must be presumed. The TRIPS Agreement Signs must be eligible for registration as trademarks.

Where signs are not inherently capable of distinguishing the relevant goods or services, member countries are allowed to require, as an additional condition for eligibility for registration as a trademark, that distinctiveness has been acquired through use. Members are free to determine whether to allow the registration of signs that are not visually perceptible (e.g. sound or smell marks). Members may make registerability depend on use. However, actual use of a trademark shall not be permitted as a condition for filing an application for registration, and at least three years must have passed after that filing date before failure to realise an intent to use is allowed as the ground for refusing the application.

Of an identical sign for identical goods or services, a likelihood of confusion must be presumed.

The TRIPS Agreement contains certain provisions on well-known marks, which supplement the protection required by the Paris Convention, as incorporated by reference into the TRIPS Agreement, which obliges members to refuse or to cancel the registration, and to

prohibit the use of a mark conflicting with a mark which is well known. Furthermore, the protection of registered well-known marks must extend to goods or services which are not similar to those in respect of which the trademark has been registered, provided that its use would indicate a connection between those goods or services and the owner of the registered trademark, and the Interests of the owner are likely to be damaged by such use.

Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take into account the legitimate interests of the owner of the trademark and of third parties. Initial registration, and each renewal of registration, of a trademark shall be for a term of not less than seven years. The registration of a trademark shall be renewable indefinitely. Cancellation of a work on the grounds of non-use cannot take place before three years of uninterrupted non-use has elapsed unless valid reasons, based on the existence of obstacles to such use are shown by trademark owner.

Circumstances arising independently of the will of the owner of the trademark, such as import restrictions of other government restrictions, shall be recognized as valid reasons of non-use. Use of trademark by another person, when subject to the control of its owner, must be recognized as use of the trademark, for the purpose

of maintain the registration. It is further required that use of the trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form, or use in a manner detrimental to its capability to distinguish the goods or services.

Chapter first deals with the intellectual property protection on genetic resources. This chapter further divided into eight parts:

1. Transfer of technology related to the biotechnology, 2. Indian legislative scenario, 3. Plant Variety Protection and Farmer Rights, Act 2001, 4. Biological diversity law, 5. The Patent Amendment Act 2002, 6. Patent (Amendment) Ordinance 2004, 7. Law on plant and 8. EPOV Convention.

Chapter second deals with the intellectual property protection and information technology Act. This chapter is divided into six parts dealing with: Historical background of information technology; Problems of infringement; information technology Act 2000; Induction of digital time stamping service in India; E-security: protection of Intellectual Property Right. The E-security and protection of intellectual property right are discussed under five subheadings namely (i) User authentication property (ii) Encryption and compression (iii) Intrusion detection system security (iv) Detection system security (v) Technical protecting Services. Again this is discussed under the

three heading such as (a) protection intellectual property right : need of copyright education (b)operation of intellectual property law in the new digital environment and need of strict law and effective implementation (c)need of data and research collection.

So far as the main problem addressed in this work discussed in Chapter III. For the sake of analysis this chapter is divided into six parts: 1. Deals with concept and definition of trademark, 2. Type of trademark, 3. How to use trademark correctly, 4. Trademark licence and assignment, 5. Un-registered trademarks and passing off and 6. Infringement of trademark. This chapter is further sub-divided in to two parts namely, (a) Availability of trademark for registration and (b) The protection and enforcement of IP and TRIPS agreement.

The availability of trademark for registration are discussed under seven sub-heading namely, procedure for registration; who can file an application; malafied intention must not to use; duration of trademark; hearing of the parties; rectification or cancellation of a trademark; assignment and transmission. Similarly the protection and enforcement of IPR and TRIPS agreement are discussed under six sub-heads such as (i)General application(ii) Civil and administrative provisions(iii)provisional measure (iv)special requirements related to border measure (v)enforcement by state parties (vi)protection and enforcement of intellectual property right in India.

Chapter IV deals with the domain name and trademark law. So far this chapter is divided into 8 part dealing with (1) the concept and definition of name, (2) domain name dispute and trademark law (3) position in U.S. (4) position of U.K. (5) position in India, (6) the role of judiciary on domain name passing off (7) Global scope.

So far as the main problem address in this work is concerned, it is discussed in chapter V. For the sake of analysis, in this chapter of the judicial response to intellectual property protection to trademark law, seven important, well-known and celebrated cases have been selected. These cases are critically analyzed in so are and they touched highly sensitive issue of IPP and trademark law.

To sum up entire discussion in the 'six chapters' of this work a brief conclusion with sum suggestions are presented at the end of this academic venture.

Chapter - I

Intellectual Property Protection (I.P.P.) on Genetic Resources

An Overview

The last decade has seen two important international instruments, the convention on biological diversity, 1992 and the Agreement on Trade Related to Intellectual Property Rights (TRIPS), 1993 as part of WTO and are in force.¹ Most of the members of TRIPS agreement are parties to the CBD. India is parties to both these instruments.

The two main overlapping areas in these conventions, which have matter of great concern and controversy are the protection and access to biotechnological and genetic resources. Whereas the TRIPS obliges the state parties to protect the plant varieties through the patent and sui generis system. India legislated the sui generis law, the protection of plant varieties and Farmers Rights in 2001 and notified its rule in 2003. However, the Act is yet to be enforced.

This chapter first examines to transfer of technology related to biotechnology and India legislative scenario for the protection of plant and plant varieties. After that it further enhance the plant varieties protection and Farmer Rights Act 2001, biological diversity law, biological diversity bill 2002.

¹ The CBD Entered into force on Dec. 29, 1993, and has been ratified by more than 160 Countries; TRIPs is binding on 136 countries at present.

This will be followed by the patent (Amendment) Act 2002, a the patent (Amendment) ordinance 2004, patent law on plant and UPOV conventions.

Transfer of Technology related to the biotechnology

Transfer of technology is a process which, irrespective of the modality choosen for the transfer, comprise three different steps such a comprehension, communication and absorption.

Subsequently over the past five century patents have been used to transfer of existing technology from technologically advanced countries. Historically speaking, countries which lagged, behind in the technology race used patent, catch up with countries, which are technologically more advanced. Technology for specific period of time and patents provided monopoly or exclusive right to the person introducing the invention giving the person reward and protection.

According to the Article 16 of the Convention on Biological Diversity (CBD, 1993), deals with the Intellectual Property Rights and transfers of technology related to the genetic resources. It provides that contracting party, recognizing that technology includes biotechnology and the both access to and transfer of technology among contracting parties are essential elements. For the attainment of the objectives of this convention, undertake, subject to the provisions of this Article to provide or facilitate access for and

transfer to other contracting parties of technologies that are relevant to the conservation and sustainable use of biological diversity or make use of genetic resources and not cause significant damage to the environment.

The convention on biodiversity does not impose a duty on state to allow access to their genetic resources.

The Article provides access of for transfer of technology the other parties which are relevant to the conservation and sustainable use of biodiversity on make use genetic resources do not cause of damage environment.

It provides access that transfer of technology to the developing countries have to take place on fair and most favourable terms including concessional and preferential terms.

However today context of patents are used as instrument to prevent technology transfer from advanced countries and transfer of knowledge is seen in piracy. For example, in the 14th century, England later become the home of the industrial revolution was in fact a laggard compared to other European countries technology. However in case of technology subject to the patents and other intellectual property rights such access and transfer shall be

provided on terms which recognize and are consistent with the adequate and effective protection of IPR.²

However, it enjoins members to recognize proprietary rights in genetic based technology and protect them through patents or other measures so as to provide effective protection.

As the IPR and patents may influence the implementation of the Convention on Biological Diversity (CBD), particularly the transfer of technology. There is obligation of the contracting parties to cooperate in this regard "subject to the national legislation and international law in order to ensure that such rights are supportive and do not run counters to its objectives."³

The reference to the international law on patents and IPRs clearly includes the obligations contained in the TRIPs agreements. What is not clear is that in case of conflict between two, which will get precedence since para 5 of Article 16 makes IPRs supported to the objective of CBD?

Article 22, which further provides that the CBD "shall not effect the rights and obligations of any contracting parties deriving from any existing internal agreement except where the exercise of those rights and obligations would cause of serious damage or threat of biological diversity" both provisions together provide a strong case

² Article – 16 ; Para 2.

³ Para 5.

for CBD to prevail over obligations under any other agreement including TRIPS.

The United State of America has not ratified the CBD so far. Its biotechnology industry has raised objections to the convention alleging that:

1. It provides basis to the parties, particularly developing countries, to reduce IP protection.⁴ Its opens the door to compulsory licensing arrangement by them. There is fear that because of the immense potential of biotechnology to the solve the developing countries food and health problems. They may introduce compulsory license for biotechnology related to patents.

Article 8(i) of the TRIPS authorizes its member in formulating or amending their national laws and regulations to “adopt measure necessary to protect public health and nutrition and to promote the public interest in sectors of vital importance to their socio-economic and technological development” provided such measures which are consistent with other TRIPS provisions. A member is also authorized to issue compulsory licensces in case of publics noncommercial use⁵ or to remedy competitive parties⁶. On the other hand the agreement provides that the protection and enforcement of IPRs should

⁴ Article 31 (b)

⁵ Article 31 (k)

⁶ Article 31 (k)

contribute to the promotion of technological innovation and transfer and dissemination of technology, "to the mutual advantage procedures and users of technological knowledge and in a manner conducive to social and economic welfare and to a balance of rights and obligations."⁷

Indian legislative scenario

Recently, India has brought various legislative instruments, for the protection of plants and plant varieties. They are relevant in the area of biodiversity genetic resources. They include Patents Act, 1970, and the Protection of Plant Varieties and Farmer Rights Act 2001 (PPVFR Act). The Patent Act, 1970 was amended twice in 1999 and 2002, in the harmony with the TRIPS Agreement. They also include other Acts such as Geographical Indications (Registration and Protection) Act, 1999, and the Biological Diversity Act 2002, Environment Protection Act 1986 (EPA) and Seeds Act, 1966. Patent Rules have been revised as well in 2003, to give effect to the amended provisions and has been enforce since 20 May 2003. Plant varieties do not constitute patentable subject matter. However inventions are patentable and the definition of invention includes process and products. However, as of now, product patents are not granted for substances intended for use, or capable of being used, as food for human consumption, or as machine or drug, and substances

⁷ Article 7 of the TRIPs

prepared or produced by chemical processes, including biochemical, biotechnological or microbiological processes.⁸ These limitation for the grant of product patent in India may have to be severed by the deadline 1 January 2005; Sec 5 of the Act is vogue will have to be deleted. Product patents and on genes still remains a grey area. The scope of process patent in the existing patent system in India is enlarged. Patent may be granted for a new method or process of testing during the process of manufacturing. This may imply grant of process patents on verifications technology related to protocols for plant and plant varieties. Process patent may also be granted for curative, prophylactic, diagnostic, therapeutic or other treatment of plants to render them free from disease and pests. Thus processes to manufacture, test and use a whole range of agrochemical on plants and plant varieties can be patented as per Indian Law. These new provisions may benefit the inventors whose patent application filed in India or PCT member countries and are in pipeline. However, exclusion of methods of agriculture or horticulture from patentability (Sec. 3) remains another grey area, several competitive and precise methods of commercial agriculture/horticulture may qualified for patentable processes in relation to plants and plant varieties in case there no such exclusion.

⁸ See 5 of the Indian patent Act, 1970, amended by the amended Act, 2002.

The Protection of Plant Varieties and Farmers Rights (PPVFR) Act along with the protection of plant varieties and Farmers Rights Rules, 2003 is in places but yet to be enforced. It is a sui generic Act, tending to provide a balance between the rights of breeders and farmers. PVP may be provided to new varieties and also to extend the varieties⁹ (including farmer varieties, and the varieties of common knowledge). The Indian sui generic PVP recognizes and respects the political historical realities of Indian agriculture. It is balanced with a set of farmer rights including, right to register farmers varieties, entitlement for benefit sharing for the use of biodiversity conserved by the farming community, right to save, use sow, lesow, exchange, share or sale farm produce including seed of registered variety but note the branded right claim, compensation for under performance a right protected variety from its promised level under defined production, conditions mandatory need to secure consent of farmers when a farmer variety is use to develop EDP, protection from legal proceeding alleged infringement, exclusion feeing legal protected varieties from its promised level under defined production, mandatory needs to secure consent of farmer(s) when the farmer varieties is used to developed an EDV, protection from legal proceeding related to related to alleged infringement, and

⁹ In strict sense, extent varieties may be those notified under the seeds Act, 1966; however as per definition in the PPV Act, 2002, those also include the farmers varieties and the varieties of common knowledge.

exclusion from paying fee in any legal proceeding in the tribunal and High Court.

The Geographical Indication (Registration and Protection) Act 1999, together with the Geographical Indication (Registration and protection) Rules, 2003 broadly provides for the registration of geographical indication (GI) of Indian goods, including the agricultural goods (Plant and Plant varieties or produce), the registration of authorize users of such registered Indian GI goods and the registration of GI of foreign goods in the territory in India where these goods are to be commercialized. The Biological Diversity Act, 2002, along with Biological Diversity Rules, 2003, provides matter to access Indian bio resources maintenance of people's biodiversity registers, equitable benefit sharing and conservation of biodiversity.

The environmental protection Act, 1986, along with relevant rules provides an umbrella Act that covers regulation of biotechnological research and other biosafety matters. The Seeds Act, 1966 is under process of revision to provide for regulatory matters related to testing Value for Cultivation end Uses (VCU) of varieties before their market approval release. The market approval of all varieties including those protected by the PPVFR Act may be made essential under the revised Act.

Plant Variety Protection and Farmer Rights Act 2001

According to the Article 27(h) of the TRIP agreement, India and other developing countries has to be devise mechanism for the plant varieties protection but have liberty to choose whether they want to introduce patents or provide an alternative form of protection. The introduction of plant varieties protection thus constitute a significant departure from the existing regim¹⁰ In India protection of plant varieties through I.P.R. has historically been denied as is reflected in the main provision patent Act of 1970.

The main focus of the Act is to refining Plant Breeder Rights. The extended to the all categories of plants it also include microorganism. It is primarily based on Union for the Protection of Plant Varieties (UPOV) convention.

The protection of plant varieties and farmer rights bill is mainly focuses on the definition Plant Breed Right (PBR) and follows closely in the model of the U.P.O.V conventions and strives to achieve

1. Promotion and growth of seed industries through domestic and foreign investment.
2. Recognition of role of farmer and a cultivation, conservation.

¹⁰ Id. A 124 following objective

3. The contribution of the rural and tribal community to the country agro biodiversity.
4. Benefit sharing and protection of sharing rights of the farmers and breeders (Section 5), the protection of plant varieties and Farmer Rights Act, 2001.

To achieve these objective's and Farmers Rights authority will perform the function, which interalia are:

1. Promotion and development of new varieties of plant and rights of farmer and breeder.
2. Registration of new plant varieties.
3. Characterization and documentation of varieties.
4. Compulsory licensing of protect varieties.

Furthermore article 66(2) of the TRIPS agreements provides that developed countries shall establish incentive to enterprise and institutions in their territories for the purposes of promoting and encouraging technology transfer to the least developed countries. Thus these TRIPS provision are consistent with article 16.4 and Article 17 and 19 of the CBD which refer to transfer of technology to developing countries that is largely under the control of the private sector in developed countries.

Article 16 of the CBD stems from the acknowledgement that conservation of biological diversity generate opportunity costs for biodiversity rich countries that are not in control of the adequate and necessary technology in order to achieve the convention's objectives. It established a legal framework that seeks to reduce those cost yet undermining the I.P. system. Firstly access to transfer of technology should take place under the fair and most favourable terms. The common meaning of that term indicate that technology transfer contracts should adopt conditions prevailing on the intellectual property market on the international technology market price discrimination or I.P.R. protection to plant. It is also required them to encourage of the overall objectives¹¹ of the TRIPs agreement. Similarly Article 27.1 requires granting patent in all field of technology, whether products or process for all inventions that novel, non obvious and industrial a filterability (usefulness). Article 27.1 states that a subject to the provision patents shall be available for any inventions, whether products or processes in the field of technology, provided that they are new involves an inventive and are capable of industrial application, subject to this Article, patent shall be available and patents rights enjoyable without discrimination as to place of invention in the field of technology and whether products

¹¹ Trips agreement Article 7: Objective. The protection and enforcement of I.P.R. should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of technology knowledge and in manner conducive to social and economic welfare, and to balance of rights and obligations.

are imported or locally produced such varieties of plant patents open up future possibilities of witnessing dispute cause in the TRIPS Council against countries not providing I.P.R. to plant or market segmentation. It is apparent that the term agreed does not allow for compulsory licenses since a compulsory license, by definition is not "mutually agreed." However compulsory license are granted, remuneration paid by the country according to the protected technology must be adequate in the circumstances of each case, taking into account the economic value of the authorization. These views hold by developed countries make it amply clear that no technology is forthcoming to developing countries, which denote provide affective protections for I.P.Rs.

According to Article 27.3 (b), which needs, "members may also exclude from patentability plants and animal other than microorganism and biological process of the plants or animal other than non-biological and microbiological process. However the members shall provide for the protection of plant varieties by patent or by an effective sui generis system or by any combination there of. The provisions of this subparagraph shall be reviewed four year after the entry into force of the W.T.O. agreement. The various interpretations from the Article could be that the W.T.O members must grant patent for :

1. Non-biological process for the production of plant

(a) microorganisms, (b) non-biological process for the production of plant (c) microbiological process of for productions of plants and microorganism.
2. Must provide protection for plant varieties which is granted by patent or effective sui generis. I.P.R. or both I.P.R. all sui generis I.P.R.
3. May exclude plant for patentable subject matter in their jurisdictions. Alternatively they may provide patents for plant and
4. May not make any alternate/sui generis provision of I.P.R protections for plant where they choose to exclude plant from patentability.

According to the above interpretation of Article 27.3(b) countries are not obliged to grant. The TRIPS Agreement does not define invention and it does not refer to the term 'discovery' where as discoveries are allowed patent grant in U.S.A. and other countries do not recognize discovery as an inventive step, which is essential condition for the grant of patent. It is important here to observe that IPR protections for plants and plant varieties much earlier than the Uruguay Round of GATT negotiations or the establishment of W.T.O.

in 1930, a legislative instrument was established in U.S.A for patenting varieties of a sexually plants. In 1961's an international conventions (convention of the Union of the protection of new varieties plant original in French (Union International Pour La protection des abstentions vegetables (UPOV) was held albeit with the countries to negotiate and provide for the protection of new varieties of plants, and triggered enactment of plant varieties protection law in countries of Europe. Further, the effective sui generis system of protection for plant varieties mentioned in the TRIPS. Articles 27.3(b) which is based on the UPOV system plant varieties protection and grandly plant breeder's Rights (PBR) on the protected varieties. The convention has already 54 countries parties to it as on 15 April 2004.¹²

As India has ratified the W.T.O agreement, it was obligatory under the Trips for India to meant the new laws and amend the patent Act, 1970 suit the International agreement for harmonizing the patent law. According to process of amendment started in 1995, the first amendment was made in 1999 through ordinance while the and second amendment was passed by the Parliament in 2002. The Protection of Plant Varieties and Farmers Right Bill was put before the Lok Sabha where it was passed on 16th August, 2001 and was enacted by the Parliament on 15th November 2001 as an Act Nov 53

¹² U.P O.V. state party to the convention, <http://www.upov.org/en/about/members/pdf/member/pdf>.

of 2001. "An Act provide for the establishment of an effective system for protection of plant varieties.¹³ The right of farmer and plant breeders and encourage the development of new plant varieties."

The Act is unique and taken into the consideration most of the points of the UPOV system. Essentially it took into consideration:

1. Importance of Research workers in developing the new varieties.
2. Farmer who are continuously generating the better varieties by network selection.
3. Fact that 80% of the seed produced in the country comes from traditional farmers which is reserve of what is happening in US

Accordingly in order to encourage the farmers a concept of national gene fund has been put in place that will be used to reward the farmers for conserving biodiversity and developing new varieties and sustainable used for genetic resources. It has also been able he effect two green and white revolution to which advantage of the country, if is felt that in further scientists will develop and protect new end improved varieties that will give commercial advantage, to the breeder. The individual institutions which are actual inventor (the licensors) should be release these new varieties under specific plant and material transfers because of following reason:

¹³ Protection of plant varieties and Farmers Rights Act 2001. Alanka Publication Delhi, 2002).

1. The intellectual property associated with the invention restrict the licensee from horizontally transforming the material without the knowledge of the actual invention.
2. Remain informed about the new varieties being developed in the other R & D organization using transform varieties.
3. Recover the cost of developing the new plant varieties: earn Royalties by transforming the material to the different parties against the considerations¹⁴

Biological Diversity Law

On Dec 4, 2002, the Indian Parliament has passed a Biological Diversity Act which is based on 12 chapters containing 63 sections and in response to the United Nations Convention on Biological Diversity Signed at Rio de Janeiro on 5th day of June 1992.

This newly passed Biodiversity Act is primarily aimed at to regulate genetic resources and associated knowledge with the purpose of securing equitable sharing of benefits arising out of the use of these resources and knowledge with the local people, who are conservers of biological resources and holders of knowledge and information relating to the use of these resources; and to protect the knowledge of local communities, related to the biodiversity.

¹⁴ Erbach F.H. and Maredia K.M. (ed.), I.P.R in Agricultural Biotechnology University Press (India) Limited, Hyderabad 2000, 31-33.

Companies are allowed free focus to the biological resources, within a country for research purposes but are barred from transforming finding to foreign entities without the M.B.A. approval. But all these provisions, only succeed in bring biodiversity under a maintain of bureaucracy that can only serve to alienate ordinary farmer from their resources while making inter national biospirecy easier, says leading activist Sumnam Sahai of the Gene campaign and Vandana Shiva of the RESTEs, is "by exchanging agriculture from the Acts provision global corporation can still gain access to valuable biological resources" Said Shiva. But an impoverished local farmer who allows his cow to fraze freely on the common could find himself penalized for inadvertently destroying a herb considered the valuable biological resources.

Sahai was of the view that the Act was weak on the issue of I.P.R. All that is stipulated in that IPR applications will have to go through the NBA and in its confused way ends up running to the national and international campaign against patent on life forms. She said because there is no structure on patent in the Act, the NBA could now actually give permission form someone to take a patent out on a rare species of say, a turtle or a bee. In fact that new law would undo protection against the patenting of life forms contently to earlier path breaking legislation such as Plant Varieties Protection and Farmer Rights Act (PPVFR) passed last year through it does not

recognized breeder's right, which again benefit large seed transactional corporations.

The Biological Diversity Bill 2002

One of the major challenges before India lies in adopting an instrument which helps to realize the objectives of equitable sharing of benefits which is contained in the CBD.

The proposed legislation in order to give effect to the CBD is primarily aimed at to regulate access of genetic resources with the purpose of securing equitable sharing of benefits arising out of the use of these resources with the local people, who are conserves of biological resources and holders of the knowledge and information relating to the use of these resources. It also protect knowledge of local people related to the biodiversity. For this purpose the Act envisages the national biodiversity, state biodiversity board and biodiversity management committee. The national biodiversity authority (NBA) is the nodal body to over see the implementation of the Act, and Act also issue the guidelines for the access to and equitable benefit of sharing of genetic resources.¹⁵

The Patents (Second Amendment) Act, 2002

In order to bring its patent law in line with the TRIPs agreement, the Act was again amended through the Patents

¹⁵ Clause 18.

(Amendment) Act, 2002; on the lines as delineated above to make it TRIPS compliant.

The bill has made biotechnological process as a patentable and extend the patent term to 20 years from existing 14 years from the date of application for patent in case of drugs and pharmaceutical products and other products respectively.

With the inclusion of Basmati, Kerala, Jamun, Gulmurr, Neem and Turmeric extracts, new provisions are incorporated whereby recognition will be given to the practice of such plant and product based on orally conveyed tradition and the endeavour will be made to public domain knowledge.

The word invention is also defined again to include the product patent in addition to the process. Section 5 of the amendment also includes biotechnological and microbiological products, and process thereof, process using extracts, derivatives from herbal sources, chemical pharmaceutical products per se, novel semi-conducting substance (However the examination will be deferred till Jan 1, 2005, under Mail Box system).

In the patent field, the main challenges posed before the Government of India under the TRIPS are in the fields of pharmaceuticals, chemicals, biotechnology, plant variety protection and the protection of undisclosed information. Indian Patents Act,

1970 did not provide product patents for pharmaceutical and chemicals. In the new Act, section 53 of the Patents Act, 1970 stands amended by omitting the distinction between product and process patent. It provides a uniform term of twenty years for all categories of inventions. But the patents granted before the Act of 2002, if they cease to remain operate due to non-payment of renewal fee or on expiry of the term the subject-matter covered by the said patent will not be entitled to any further protection. The Act has provided necessary safeguards for the protection of public interest, national security, biodiversity, traditional knowledge, etc. Being the party to the PCT, the amended Act also tries to harmonise the procedure for grant of patents in accordance with international practice (Chap. II A of the Patents Rules, 1972 as amended on 2 Dec. 1998).

Whereas the new Act align the provision relating to compulsory licensing of the TRIPS, the provision relating to licenses of rights have been omitted from the 1970 Patents Act. But unlike TRIPS Agreement, the new Act retains the provision on the revocation of patents by the Controller of Patents for non-working. Section 85 provides:

“Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the

order granting the first compulsory licence, apply to the Controller for a order revolving the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.”

It also excluded from patentability such as DNA cell, seed, essentially biological process for production of plant and animal, mathematical and business method and computer programmes, any process or product that causes harm to human animal or plant life literary dramatic musical or artistic work or any cinematographic or television work, presentation of information a mere scheme or rule or method of performing mental act or method of playing game.

It also incorporate provision for the protection of biodiversity and traditional knowledge (under section 28 of bill) by refusing to grant patent if the application wrongfully mentions the source or geographical origin of biological materials.¹⁶ The provision has also been made for the appellate board, which shall be the same as created under the trademark, Act 2000.

¹⁶ Section 24 revocation of patent under the new provision a patent can be revoked when” the complete specification does not disclose a wrongfully mention the source or geographical material used for the invention.

At present every patent after 3 years from the date of sealing of a patent are deemed to be endorse with the "License of rights" become open for other the claims for the same on the grounds such as not fulfillment of the demand of the patent products of reasonable price.

Patent (Amendment) Ordinance 2004

It is not unforeseen that India is amending its patent laws for including product patents within the country to meet the deadline of ushering in the product patent regime from 1 January 2005. The NDA government introduced the bill in the Lok Sabha on the very first day of winter session. But the bill was lapsed when general election called in March 2004.¹⁷ Once again the UPA government introduced the ordinance, promulgated in Dec. 2004 makes wide ranging changes to the Act and paves the way for the product patent regime to replace the process patent system.¹⁸ A process patent only protects the method or process that patent holder uses to manufacture a drug. This allows other pharmaceutical companies to make the same drug using a process different from the one that is patented. The difference versions of the medicine the produced are called generic drugs.

¹⁷ Business Line, New Delhi, 23 Dec., 2003.

¹⁸ Frontline, Feb 25, 2005, p.97.

The British framed patents and designs Act (1911), which was enforce until the 1970 Act was legislated, provided for the product patent system. Prior to the 1970, 85 percent of medicines available in India were produced and distributed by multinational corporation and the price of the drugs in the country were among the highest in the world.

However, the derailment of the WTO seattle Ministerial Conference in 1999 by antiglobalisation activities forced a rethink. The Doha Ministerial Conference in 2001 adopted the Doha declaration in which countries agree to implement in the TRIPS agreement in a manner supportive of the WTO members right to take measure to protect "human, animal, plant life or health or of the environment at the levels in considers appropriate." India along with Brazil and South Africa, played a crucial role in bringing together developing countries on the issue.¹⁹

Circumstances leading to the Amendment

With the dawn of 2005, two significant developments took place. Both are connected with the world trading order under WTO, of which India is a part one is the final phase-out of the Multi-Fibre Agreement, and the other is marked by India's conformity with the international intellectual property system.

¹⁹ Frontline, Dec. 2, 2001.

The WTO system provides an organized multilateral framework within which India can claim trade demands as a legitimate right; and in this the country had succeeded to a large extent. The country's exports stood at less than 32 billion dollars ten years back. A decade later they had doubled to 64 billion dollars. All this translates into more employment opportunities and greater economic activity, with its concurrent benefits.

The pharma and the IT industry are the two sunrise sectors for India. The ordinance amending the patent act provides for an enabling environment for both of these. Among the sectors that have experienced the greatest transformation in India, the Pharmaceutical Industry is perhaps the most significant, India's WTO involvement during the last decade has encouraged her pharma companies to adopt a strategy of R & D based innovative growth.²⁰ The transformed Indian pharma industry is itself looking for patent protection - particularly the biotech sector, in which India has aggressive prospects.

When India joined the WTO ten years ago Indian pharma exports were less than 4000 crore rupees. A decade later her pharma exports are 14,000 crore rupees, and account for more than a third of the industry's turnover. This is the result of the confidence built up in this industry due to India's progressive adherence to her

²⁰ Civil Service Chronicle, Feb 2005, p.29.

Intellectual Property IP) commitments. Apart from manufacture of drugs, the pharma industry offers huge scope for outsourcing of clinical research. The country has a vast pool of scientific and technical personnel, and recognized expertise in medical treatment and health care. India can take advantage of its strength in this provided it has the right legal framework in place, which provides IP protection to the results of that research.

In IT, the trend is to have software in combination with or embedded in hardware - such as in computers or cell phones or a variety of other gadgets. Software as such has no patent protection (the protection available is by way of copyright); but the changing technological environment has made it necessary to provide for patents when software has technical applications in industry in combination with hardware. This has been a demand of NASSCOM, the lead organisation of software industry in India.

A comprehensive review of the Patents Act 1970 was also made and a bill to amend the Patents Act 1970 was introduced in Parliament on 20 December 1999 and notified on 25.06.2002 to make the patent law TRIPS compatible.

This Third Amendment through an ordinance is only the culmination of a process begun ten years ago. The provisions of the Ordinance are to be seen in conjunction with, and in the context of

the Act, as well as of the earlier two Amendments of 1999 and 2002. Of late, the Act, had to be amended in order to provide for product patents in these areas with effect from 1st January 2005. The ordinance is to be discussed in detail in Parliament in the Budget session. The ordinance is a interim measure to fulfill India's legal obligations within the stipulated time.

IFS and BUTS

The fear is that prices of medicines will spiral. However, the government tries to allay the fear. It points to the fact that 97 percent of ~~all~~ drugs manufactured in India are off-patent, and so will remain unaffected. These cover all the life-saving drugs, as well as medicines of daily use for common ailments. In the patented drugs also, in most cases there are always alternatives available. In fact a feature of patent protection is that it spurs research, so that constantly alternatives keep appearing in the market - and often the alternatives are better ones. Thus price control is inherently built in.

The Amended Ordinance has 13 Compulsory Licensing provisions and also has strong provisions for outright acquisition of the patent to meet national requirements. There is also the Drug Price Control Order Administered by the National Pharmaceuticals Price Authority. With this framework in place it is said that the

concerns and fears expressed by various sections are wholly misplaced.

The Act ensures that the reasonable requirements of the public with respect to availability and affordability are taken care of. Public interest particularly public health and nutrition is protected. The law, it is believed, effectively balances and calibrates intellectual Property protection with public health concerns and national security.

Credit should go to the government for meeting the WTO and TRIOS deadline of putting a Patent Framework in position before January 1, 2005. However, the criticisms against it for not making wide consultations on the issue before the ordinance introduced cannot be totally invalid. The government can make some corrections when it discusses the ordinance in the budget session of Parliament.

Benefits

By participating in the international system of intellectual property protection, India unlocks for herself vast opportunities in both exports as well as her potential to become a global hub in the area of R & D based clinical research outsourcing, particularly in the area of bio-technology.

Finally

The basis obligation in the area of patent is that, invention in all branches of technology whether products or processes shall be patentable if they meet the three tests of being new involving an inventive step and being capable of industrial application. In addition to the general security exemption, specific exclusions are permissible from the scope of patentability of inventions, the prevention of whose commercial exploitation is necessary to protect public order or morality, human, animal, plant life or health or to avoid serious prejudice to the environment. From all these counts ranging from safeguarding inventions, reaping benefits and serving human needs, the Patent Ordinance 2004 is expected to serve all and sundry once it becomes a law.

Salient Features of the Patents (Amendment) Ordinance, 2004

1. The ordinance included product patent protection in all fields of technology as per article 27 of the TRIPS agreement.
2. A provision-enabling grant of compulsory licence for export of medicines to countries, which have insufficient, or no manufacturing capacity to meet emergent public health situations. This provision is in accordance with the truce concluded on 30 August 2003 just before the Cancun

Ministerial for the implementation of paragraph 6 of the Doha Declaration of TRIPS and Public Health.

3. Extension of product patent protection to all fields of technology (i.e., drugs, food and chemicals)
4. Deletion of the provisions relating to Exclusive Marketing Rights (EMRs) which would now become redundant, and introduction of a transitional provision for safeguarding EMRs already granted.
5. Modification in the provisions relating to opposition procedures with a view to streamlining the system by having both pre-grant and post-grant opposition in the Patent Office.
6. Addition of a new provision in respect of mailbox applications so that patent rights in respect of the mailbox shall be available only from the date of grant of patent, and not retrospectively from the date of publication.
7. Strengthening the provisions relating to national security to guard against patenting abroad of dual use technologies.
8. Clarification of the provisions relating to patenting of software related inventions when they have technical application to industry or are in combination with hardware.

9. Rationalisation of provisions relating to time-lines with a view to introducing flexibility and reducing the processing time for patent applications and simplifying and rationalizing procedures.
10. It seemed that the Indian pharmaceutical industry has welcomed the government's initiative to grant EMR. But he MNCs fear that the new drug price control order will curtail the freedom under the EMR facility.²¹ But the moot question is whether the new order is a violation of TRIPS agreement.

Patent Law on Plant

The entire structure of patenting of seeds and plants in the U.S. and TRIPS is based on an arbitrary decision of the U.S. patent and trademark office in the Hibbered case in 1985. In this case, molecular genetics scientific Kenneth Hibbered and his co-inventors were granted patents on the tissue culture. The Hibbered application included over 260 separate claims. Which gives the molecular genetic scientist the right to exclude other from use of all 260 aspects prior to this 1985 decision starting in 1930 the US congress has granted carefully crafted IP protection for plants. But these law included important exemption for farmer and researchers. The 1985 decisions redefines plants as a machines and other manufacture, and since

²¹ Shah G.D. Secondary General, Indian Pharmaceutical Alliance, www.hindubusiness.com 29, Dec, 2003.

than thousand the patents on plant have been given in USA. The US has also pressurized the rest of the world to implement plant patents through TRIPS. The US IPR orthodoxy is based on a fallacious idea that the people do not invent or generate knowledge unless they can derive private profit. However, greed is not a fundamental fact of human nature but a dominant tendency in society that rewards it. In the area of seeds and plant genetic resources both the formal and informal systems have so far been guided by larger human good.

UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS CONVENTION

UPOV convention was adopted initially by five European countries and membership was restricted to European countries till 1968 at that time the convention was revised and membership opened to all countries. UPOV was signed in 1961 and it came into force in 1968. The existing international convention that covers plant, breeder rights is the international convention for the protection of new varieties of plant: - The UPOV convention 1978 was again revised in 1991 and came into effect.

Presently there are twenty member states of UPOV including most EC countries several European countries, Japan, US and some others. It has no developing countries members. It has therefore, evolved as a legislation suitable to the socio-economic context of

industrialised countries where farmer do not form a large part of the population and do not have any contract over plant breeding on seed supply. The majority of the population continued to be engaged in farmer and farming seeds production, and supply system is still the main source of seed.

The main objective of the UPOV convention is to grant exclusive right to plant breeders and developed new varieties of plant. Normally, the farmer provide the source material to the breeders for the developed new varieties. They are also users of the new varieties developed by the breeders. There is need to balance between breeders rights and what is called farmer privilege. However, the UPOV convention is rigid, requiring that members adopted the its standard and scope of protection as a national law.

The standardization is built into the way plant varieties are defined. To eligible for protection, a variety must be:

1. The variety must not have been exploited commercially.
2. It must be clearly distinguishable from all other varieties known as the date of application for protection.
3. All plants of those particular varieties must be sufficiently uniform to allow it. To be distinguished from other varieties

lacking into account the method of reproduction of the species.

4. It must be possible for the variety to be reproduced unchanged.

The definition by its very nature rules out farmers varieties and destroy biodiversity and produces uniformity as necessity. The reward under such a system of plant breeding right (PBR) does not go for breeding to maintain and enhance diversity and sustainability, but the destruction of biodiversity and creating uniform and hence ecologically agricultural system. While UPOV fails to protect the farmers right as positive rights. UPOV 1978 does not have a farmer exemption which gives the farmer the right to save seeds to the protected varieties. To avoid more restricted 1991 convention, the most governments were rushing to become members of the 1970 convention and basing their sui generis system.

The UPOV provides (i) model act to administer the protection of new varieties of plants at national level, (ii) guidelines for uniform application of examination of essential characteristics of candidate varieties across the member countries (iii) test guidelines for varieties for different plant species, countries are encouraged to accept the guidelines *per se* after some modifications that may suit well to their national requirements, and (iv) technical assistance to

developed National Test Guidelines and for general administration of the plant varieties protection Acts by countries. The most important application of the system is that it provides a multilateral platform wherein applicants from different UPOV members countries can enjoy priority date of first filing for their PVP application for the same variety in other member countries.

The PVP application are not examined and published like the patent application under the PCT (The Patent Cooperation Treaty, 1970) on over all costs.

Chapter - II

Intellectual property protection and information Technology

An Overview

The revolution in information technology is changing access to information technology in fundamental ways. Increasing amounts of informations are available in digital form; networks interconnect computer around the glob; and worldwide web provides a framework for access to a vast array of information. Yet the same technology raise fundamental issues concerning intellectual property rights. Because the technology that makes access so easy also greatly aid copying both legal and illegal. As a result, many of the intellectual property rules and practices that are evolved do not work well in digital environment.

Internet today revolutionized the world of communication It has brought the whole world at the click of the mouse. It has simultaneously increased the promise and the perils of information and communication technology. It is removed all the trade barriers and has transformed the world into a small village. By dramatically reducing the cost of imitation and diffusion of illegal copies it has tremendously increased states of intellectual property for entertainment and software companies as well as for various information provides such as database procedure. The main area of concerned has been copy right, with the extension of copy right to software in large number of countries and rapidly evolving issue of

implementation as new technology enable better monitoring of diffusion of the web.

This deceptive simple problem of information technology and intellectual property rights illustrate the combination of challenges and prospect that make the arena of information technology world and intellectual property rights. The information technology by way of information in digital form, computer networks, and the world wide web has given rise to contradictory powers and promise.

Technological changes always create a challenge to the basic principle of I.P.P. law. Internet and digital revolution pose complex for intellectual property their protection the three technological advances, namely, the digitization of information, networking and www (world wide web), have primarily turned the economics of reproduction, networking has change the economic of distribution; www has changed the economics of publication.

Historical Background of Information Technology

During the later half of 20th century, dramatic shift from paper to bits occurred. However, creating trust in an e-environment requires assuring the transacting parties about the integrity and confidentialising of the content of documents along with authentication of the sender and receiver in such way that both parties cannot repudiate the transaction. I.T. Act 2000 was enacted in

India allowing transactions signed electronically to be enforceable in a court of law. The shift from paper to bits combined with the ability and necessity to bring digital data to courts, however creates, a sensitive issue. How do we prove the integrity of this new form of information known as digital evidence still remains a challenge and varies from case to case.

Digital evidence originates from various sources like hard disk drivers back up media, real time email messages, chat room logs, ISP. Records, web pages, digital network traffic, local and virtual data base, digital directories, wireless devices memory cards, digital cameras and specialized tools created for that purpose. Several technological solutions bank on extracting the digital data from these devices and network.

After extraction of the digital evidence, digital integrity becomes critical for investigator, prosecutors and those who are accused in the case. The ease with which digital evidence can be altered, destroyed or created in convincing way-by movies computer elite is alarming. To make matters worse, the need to preserve, archive and protect the integrity of digital evidence for long periods of time has become most glaring. Again the methods used today rely on the integrity of the individual's process, procedures, and physical and logical access to security. These methods are costly to implement,

fraught with potential errors, vulnerable to accidental or malicious modifications and constrain the wide spread utilization of digital evidence in crucial litigious procedures. Based on this context, the digital integrity can be define as "the property whereby digital data has not been altered in an unauthorised manner since the time it our created, transmitted, or stored by an authorized source."

To Date several methods have been adopted for ensuring and verifying that digital packets reach the receiver authentically and correctly. The table below list some typical method and their types, advantage and disadvantage.

Table 1

Important Milestones of History to Ensure Digital Integrity of Information Transacted on the Networks.

Method	Type	Advantages	Disadvantages
<p>Checksum A method of checking for errors in digital data. 16/32/64/128 bit polynomial is applied in succession to each part of digital data. The result is corresponding 16/32/64/128 bit in length. This integer value must be saved and secured. The same polynomial can be applied to the received data for comparing it with the original result for verification. If both the results match, a high level of integrity exists in the received data.</p>	<p>CRC16 CRC32 CRC64 CRC128</p>	<p>-Fast - Small data - Useful for detecting random errors</p>	<p>Comparatively low assurance against malicious attack as it is simple to create new data with matching checksum - The system must maintain secure storage of checksum values - Does not bind identity with data - Does not bind time with the data.</p>
<p>Hash Algorithm A method for protecting digital data against unauthorized change. The method produces a fixed length large integer value (ranging from 80-240 bit) representing the digital data. The method is called one-way hash function because it has two unique characteristics. First for a given hash value, it is difficult to construct new data resulting in the same hash. Second given the original data it is difficult to find other data matching the same has value.</p>	<p>SHA-1 MD5</p>	<p>-Easy -Can detect both random errors and malicious alterations</p>	<p>The system must maintain secure storage of hash values Does not bind identity with the data Does not bind time with the data</p>
<p>Digital Signature A secure method of binding the identity of the signer with digital data. These methods use a public key crypto-system where the signer uses a secret key to generate a digital signature. Anyone can validate the signature generated by using the published public key certificate of the signer. The signature produces a large integer number (512-4096 bits)</p>	<p>RS DSA</p>	<p>-Binds identity to the integrity operation -Prevents unauthorized regeneration of signature unless private key is compromised</p>	<p>-Slow -Private key must be protected -Does not bind time -If keys are compromised or certificate expires, digital signatures may be invalidated.</p>

Authenticity, integrity, and non-repudiation: In addition to providing confidentiality, cryptography is often asked to accomplish the following jobs:

- **Authentication:** It should be possible for the receiver of a message to ascertain its origin; an intruder should not be able to masquerade as someone else.
- **Integrity:** It should be possible for the receiver of a message to verify that it has not been modified in transit; an intruder should not be able to substitute a false message for a legitimate one.
- **Non-repudiation:** A sender should not be able to falsely deny later that he sent a message.

These are very vital requirements for social interaction in an electronic environment, and are analogous to face-to-face interactions.

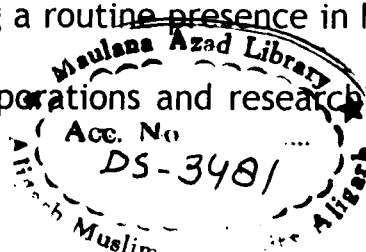
Algorithms and keys:¹ A cryptographic algorithm, also called a cipher, is the mathematical function used for encryption (E) and decryption (D). The key is a large number. The range of possible values of the key is called the key space. Both encryption and decryption use this key space.

¹ Steve Burnett & Stephen Paine, *RSA Security's Official Guide to Cryptography*, RSA Press; William Stating, *Cryptography and Network Security, Principles and Practice*, SE, PE

There are two general types of key-based algorithms: symmetric and public-key (asymmetric algorithm). The universally accepted modern method of electronic authentication is the one based on asymmetric cryptosystems. This is also known as public key cryptography, and is the basis for creating digital signatures. However, rapid advancements and technological changes are challenging the supremacy of digital signatures as the only method of electronic authentication. Biometrics and dynamic signature analysis, among other technologies, are expected to be equally important in the years to come. It is also expected that some of the biometric techniques may prove to be more reliable and less susceptible to compromise than digital signatures. In view of the pace of technological development, no single technology may prevail as long as the sole means of electronic authentication.

Problems of Infringement

The three recent technological trends are key to the possible upset of the delicate balance of interests in intellectual property—digital information, networks, and the Web. A second factor challenging the balance arises from the transformation of the digital information infrastructure into a routine part of everyday life. In India, computers and the Web are becoming commonplace in work settings and are fast becoming a routine presence in households; what was once the province of corporations and research laboratories has



become a broadly available capability. One important consequence is that ordinary citizens are now faced with questions involving the subtleties of intellectual property law, questions they are ill-prepared to answer.

A second consequence of the emergence of the information infrastructure into everyday life is that individuals find themselves capable of reproducing vast amounts of information, in private, using commonplace, privately owned equipment. A single individual can now do in private what once would have required substantial commercial equipment and perhaps criminal intent. Internet is a world in which every (digital) product carries with it the possibility of an almost magical speed, ease, and precision of predication. The information infrastructure makes private infringement of IP rights vastly easier to carry out and correspondingly more difficult to detect and prevent.

The Distribution: The digital medium creates difficulties in the way in which copyrighted products are distributed. In digital medium, a copyrighted work is licensed/subscribed for tenure rather than sold. This is in complete defiance of previous practice as before the emergence of digital era, all copyrighted materials were transferred by way of sale of physical copy of a work and could be resold subsequently. This involved the complete transfer of ownership providing rights in a copy to be transferred from the vendor to the

purchaser and to the next purchaser in sequence. However, the first sale had special significance, and is known as first sale doctrine.

Distribution by way of Internet as well as in form of prerecorded compact disks (CD's), DVD's wherein the owner's identity can be easily changed/altered is another major problem calling for Electronic Right Management Systems and their regulation in term of WIPO Copyright Treaty (WCT) and WIPO Performances and Phonograms Treaty (WPPT).

Caching: The second problem posed by Internet is the question of what constitutes copying in the digital medium. There is a intimate connection between access and copying in the digital environment. The essence of IP laws is to confer upon authors the exclusive right to right in digital medium posses difficulties. For a user to view a document, a copy of the document must be loaded into the memory of the computer. Whether this temporary copy in memory should be considered a reproduction under the copyright law is not free from controversy. Caching is storing of the web pages in computer memory at user level or server level. Caching is a temporary storage of previously loaded or downloaded document by client's computer or server computer. Proxy servers are installed in networks near the points of contacts to the Internet to provide safety security, sender' identification etc. Proxy servers store local copy of all web pages in their cache memory and when a request is made for the same web

page, it serves the web page from the local storage rather than to access the original website which is time consuming. In other words, a proxy server intercepts all Internet request and tries to fulfill them locally. This type of caching is known as proxy caching or server caching or server caching. This speeds up the Internet access, conserves valuable bandwidth and helps in preventing traffic jams in cyberspace.

A document will remain in the proxy cache for several hours or even days. Copies made in proxy cache are privately intended for communication of the cached works to other users and such caching may amount to reproduction even though the documents are stored temporarily. The Berne Convention does not provide for general right of distribution or right of communication to the public. Article 8 of the Wipo Copyright Treaty (WCT) provides that the authors of literary and artistic works shall enjoy the exclusive right of authorizing and communication to public of their works by wire or wireless means including the making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them. The restatement-accompanying article 8 of the WCT suggests that passively acting online intermediaries by way of "ephemeral copying" do not themselves perform acts of communication to the public for which the

might be held directly. IN India, as per section 79 of IT Act 2000, network service providers (NSPs) are not to be liable in certain cases.²

Section 79 For the removal of doubts, it is hereby declared that no person providing any service as network service provider shall be liable under this Act, rules or regulations made there under for any third party information or data made available by him if he proves that the offence or contravention was committed without his knowledge or that he had exercised all due diligence to prevent the commission of such offence or contravention.

Explanation - For the purpose of this section.

(a) "Network service provider" means an intermediary;

(b) "Third party information" means any information dealt with by a network service provider in his capacity as an intermediary;

Again certain moral interests may be compromised because of proxy caching since proxy caching may result in the supply of non-recent documents if proxy cache is not regularly refreshed.

Search Engines: Third problem posed by Internet relates to search engines. A search engine builds periodically a directory of frequently accessed sites and also of the meta tag which are primarily the key words. Question arises whether a return produced by search engine

² See, <http://www.mit.gov.in/it-bill.asp>-Information Technology Act 2000, India.

links a content that contains infringing materials, and it may constitute a copyright infringement?

Linking and deep linking: Linking and deep linking pose new problems for copyright. HTTP (Hyper Text Transfer Protocol) as such facilitates linking of one website with another without the knowledge or consent of the owner of the linked website. Linking raises question whether the link provider is liable for copyright infringement or not? Similarly, deep linking occurs when selective contents of subordinate pages of a home page are linked by another person thus bypassing the top page in the hierarchy leading to loss of revenue due to the fact that the user will not be aware of the real of the site.

Protection of confidential information: The issues include what is protectable confidential information? What is an obligation of confidence? How does an obligation of confidence arise? How long does an obligation of confidence last, how is confidential information protected? And finally, what amounts to (i) theft and industrial espionage, (ii) transmitting confidential information by the Internet, (iii) misuse of confidential information on the internet etc.

Patents: The issues include patenting and protecting ideas, patenting the computer software in general and that of Internet, business method patents, Internet publications, patent infringement through the Internet etc. majority of countries in the world decide time

element of an invention by way of "First to File rather than First to Invent". US Patent office goes the other way. Therefore researchers/inventors prove for their 'first to invent' attribute utilizing Internet based "Digital Notary" and www.etimestamp.com, www.firstuse.com, www.digistamp.com and www.surety.com.

Trade marks and domain names: The issues are that a trade mark may clash on the Internet with somebody's Internet domain name and vice versa forming genuine trademark versus domain name disputes/cyber squatting, domain name registry dispute policies, corporate trade mark and domain name protection policies. Meta-tags, word stuffing and search engine keyword sales etc.³

Defamation: Liability for defamatory statements over networks and how to deal with them legally in wake of key players - ISPs, contents creators, software owners being spread all over the globe.

Content liability and protections: Incorrect information - negligence liability/strict liability, negligence liability for virus dissemination, liability in trespass for virus dissemination, restricting liability, protecting content, liability to online intermediaries (IT Act 2000), employer liability, e-mail and internet access policies etc.

Prohibited and regulated activities: Cross-border content, gambling, pornography and sexual offences offence, contempt of court, financial

³ Alexander I. Poltorak, Paul J. Lerner, John Wiley & Sons Inc. Essentials of Intellectual Property (New York 2002).

services, advertising on Internet, encryption policy, computer misuse, hacking etc.

Payment mechanisms for Internet commerce: Electronic cash systems, fraud involving abuse of credit/charge/debit cards and analogous systems, fraud involving true electronic cash etc.

Tax: Emerging tax policies and their global reconciliation.

The Copyright Act, 1957 as amended up to 1999 is yet to take care of many of these technological changes. Major amendments to deal with the challenges posed by the computer storage, Internet and the digital revolution are still to be incorporated therein.

With India being party to Trade Related Aspects of Intellectual Properties (TRIPs), electronics transactions of IPR's and consultancy services related to them are expected to be a new possible business in India. This may also promote our technology base to keep pace with global trends. As India has already enacted IT Act, 2000, this allows transactions signed electronically for e-commerce primarily to be enforceable in a court of law. Several issues arise when we consider using digital documents and exchanging them over the Internet, such as eavesdropping, tampering, impersonation etc. All these can be remedied by the use of public key infrastructure (PKI). However, the question of when a document was created or signed still remains unanswered. This information may prove to be crucial for most e-

commerce legally binding transaction, in particular for supporting non-repudiation of digitally signed transactions. "When?" refers to time stamping. This paper is an attempt to provide a review of emerging technologies and their components in present status of infrastructure set up, major applications, the requirements and an outline how to establish a mechanism for digital time stamping service in India.

Information Technology Act 2000

Information technology (IT) Act 2000 was enacted in October 2000 to give boost to e-commerce, e-transactions and similar activities associated with commerce and trade and accordingly it has provisions in the form of legal authorization and reorganization of electronic records, legal recognition of digital signature. Information Technology Act implement these facets in the form of licensing mechanism, regulated through certifying authorities as a processes under the overall supervision of controller of certifying Authorities (CCA). As a sequel to Information Technology (IT) Act, the set for establishing controller of certifying authorities has also come up. E-commerce in its present form is in the stage of infancy in India and a limited scale, addresses Business to Business (B2B), Business customers and similar type of issue. The sprit of the information technology Act in providing scope for the appointment of the adjudicating officer is to

promote trust among the people and the corporate for the growth of e-commerce. Information Technology Act focuses on the concept of "damage compensation" through monetary payment for settling dispute rather than advocating the penalties/punishments in its strictest legal/judicial sense of the term. Information technology Act provides legal framework for e-commerce and e-governance in India.

The Act consists of 13 chapters divided into 94 sections and has 4 schedules on amendment in respect of:

1. Indian Penal Code
2. Indian Evidence Act (1872)
3. Bankers Book Evidence Act (1891)
4. Reserve Bank of India Act (1934)

Section 91. Amendment of Act 45 of 1860

The Indian Penal Code shall be amended in the manner specified in the 1st schedule to this Act.

Section 92. Amendment of the Act 1872.

The Indian Evidence Act, 1872 shall be amended in the manner specified in the second schedule to this Act.

Section 93. Amendment of Act 18 of 1891

The bankers book evidence Act, 1891 shall be amended in the manner specified in the fourth schedule to this Act.

Chapter I to VIII are mostly digital signature related. Chapter IX to XII are regarding penalties; offences etc. In the Act, digital signatures are defined as a authentication of an electronic records by means of an electronic methods. The digital signatures will have to be authenticated by the certifying authorities, which could be private companies. Controller of certifying authorities would issue license to private companies to function as a certifying authorities. The controller has power supervise the proper functioning of certifying authorities and even revoke the license.

Using best practices available today we can bind "who" (The signer) with a "what" (the digital data) using digital signature. However, digital signature have shortcoming that leave two critical issue unanswered:

1. When did the signing of the digital evidence occur? How long after evidence was seized, was it integrity protected?
2. How long can we prove the integrity of the digital evidence that we signal?

For both of this questions, times become a critical factors in providing the integrity of digital evidence. This resulted is

requirement of trusted source of time to digital evidence. A DTS issues times stamp, which associate a date and the time with a digital document in a cryptographic strong way. The digital time stamp can be used at a later date to prove that an electronic document existed at the time stated on the time-stamp.

DTA help in establishing motive, opportunity and means of cyber criminals using digital evidence.⁴ With help of DTS (Digital time stamping Service),

Under the Information Technology (IT) Act, 2000 a CA shall provide time stamping service, to guarantee the integrity of electronic records for its subscribers error which shall not more than 1-10; one can prevent insider fraud, prove ownership of intellectual property, or settle disputes with customers, competitors partners and employees: all of which have a role in upkeep of the IPR culture. The DTS can play a major role in providing the ownership of the intellectual property (e.g. patent, copyright, Design, trade secrets and trademarks) as well as infringement thereof.

Induction of digital time stamping service in India

The information technology Act 2000 provides the required legal scarcity to the digital signature, based on asymmetric cryptosystems. The digital signatures are now accepted as part of with handwritten

⁴ <http://www.etimestamp.com/>: Digistamp Company USA;
<http://www.itconsult.co.uk/stamper/stampinf.htm>. PGP digital time stamping service.

signatures and the electronic documents that have been digitally signed are treated as per with paper documents. As mentioned earlier, the Information Technology Act provides for the controller of certifying authorities (CCA) to license and regulate the working of certifying authorities. The certifying authorities (CAs) issue digital signature certificates for electronic authentication of users.

In order to overcome the electronic transaction related verification problems of digital signature, it is proposed to issue server (time-stamping server) license to trusted third parties (TTPs). The acknowledgment claims in respect of electronic transactions for actually sent, received, opened or not by both sender and receiver will be settled by these TTPs. The purpose is to designate few trusted third parties other than certifying authorities for verification of electronic transaction. The DTS should provide the following time stamping service:

- 1. Document/website time stamping:** Requester calculate unique thumbprint (SHA1 cryptographic hash) of document and sends a digitally signed "fingerprint" of the document to the DTS. The original documents never leave the user's computer. The stamper then checks the validity of the content, publisher's time stamping server accepts applications creates signed time stamp request, retrieves stamp for specified object and returns to the user. Whole

operation is registered in database and it is possible to retrieve copies to time stamp at anytime.

Transaction via email: Signed email containing recipient e-mail address is sent to the DTS. DTS on reception of message, checks correctness of electronic signature, add finger prints of message into data base (together with trusted time of reception) and sends evidence of submission to sender and notification of messages waiting for retrieval to recipient. Notification for recipient may contain information about object: its finger print and URL to Web pages, which should be used for retrieving the message if authentication turns positive, server will transfer message to recipient and send notification of such operation to sender.

Transaction via www: To use this service it is necessary to have digital ID and internet browser supporting SSL protocol Today IPRs consultancy services related with than for marketing, licensing transfer/protection, distribution and use is emerging as a new business with high returns. All above services may go a long way to promote such trade in IPR.

E Security: Protection of Intellectual Property Right

Recent years have seen the exploration of many technical mechanisms intended to protect intellectual property (IP) in digital

form, along with attempts to develop commercial products and services based on those mechanisms.

E-security involves any and all areas of protecting computers, information systems and online transactions. Security considerations include protection against attacks from the Internet and Intranet enabling trust and privacy protection for e-transactions controlling access to systems and performing security management.

Following steps can be taken to provide software-based technical protection to the intellectual property. An alternative version of the trusted system notion envisions creating software-based IP management systems whose technical protection arises from a variety of software tools, including encryption, watermarking, etc.

User Authentication and Control: User authentication ensures that the person at the remote end is who he claims to be and he is able to see only that information which he is authorized to see. Beyond use of authentication, there is need to protect data as it passes across networks.

Encryption and Compression: Can render the data unreadable if, somehow, it does get misdirected. Encryption is used widely for other purposes, such as the use of the secure socket layer in communication over the Web to protect the confidentiality of transaction, but to date has been used sparingly for IP protection. The experimental

circumvention of technologies used to protect intellectual property is a common practice in the cryptology and security R&D community, one that enables the development of more efficient and effective protection technologies. Cryptography is frequently a crucial enabling technology for technical protection services.

Intrusion Detection Systems Security: Considerations include protection against "attacks from the Internet and the intranet, enabling trust and privacy protection for e-transactions, controlling access to systems and performing security management. Host and network-based intrusion detection systems augment the protection offered by anti-virus software, firewalls, and VPNs by warning administrators of real and attempted intrusions, both from inside and outside the organization.

Technical Protection Services (TPS): That may be able to assist in controlling the distribution of digital intellectual property on the Internet, a) Security and integrity features of computer operating systems include, for example, the traditional file access privileges enforced by the system, b) Rights management languages express in machine-readable form the rights and responsibilities of owners, distributors, and users, enabling the computer to determine whether requested actions fall within a permitted range. These languages can be viewed as an elaboration of the languages used to express file

access privileges in operating systems, c) Encryption allows digital works to be scrambled so that they can be unscrambled only by legitimate users, d) Persistent encryption allows the consumer to use information while the system maintains it in an encrypted form, e) Watermarking embeds information (e.g., about ownership) into a digital work in much the same way that paper can carry a watermark. A digital watermark can help owners track copying and distribution of digital works.

Hardware-based support for IP management in trusted systems could also be done using PCs containing special-purpose hardware. Because such machines would have the full functionality of PCs, users could continue to use them for everything that they do today.

The Trusted Computing Platform Alliance, a collaborative effort founded in October 1999 by Compaq, HP, IBM, Intel, and Microsoft, is aimed at "building confidence and trust of computing platforms in e-business transactions". It plans to provide security at the level of the hardware, BIOS, and operating system, i.e., thoroughly integrated into the system in ways that would make it transparent to the user. This is a very ambitious undertaking that will require a considerable, coordinated effort.

For specific devices, like CD players, copy protection can be based on hardware built into the device. This hardware makes it

difficult to use CD-ROM recorders to create unauthorized copies of disks with commercially valuable music, software, or other content. The content of the CD-ROMs is encrypted and digitally signed. The physical copy protection technology prevents CD-ROM readers and other professional mastering equipment from copying the digital signature. This in turn prevent unauthorized copying, because the content can be decrypted only when the digital signature can be Technical Protection Service.

Protecting IP: Need of Copyright Education

The purposes of protection of intellectual property right would be well served by a program of education explaining why respect for copyright is beneficial for society as a whole making aware about both the privileges and limitations of copyright protection. Copyright is the focus here because it is the form of intellectual property law most routinely encountered by the general public. A better understanding of the basic principles of copyright law would lead to greater respect for this law and greater willingness to abide by it, as well as produce a more informed public better able to engage in discussions about intellectual property and public policy.

Operation of IP Law in the New Digital Environment: Need of Strict Laws and Effective Implementation

Digital technology enables the creation of new kinds of information products and services, which raises a multitude of legal issues. Digital repositories pose difficult questions about authorship, ownership, and the boundaries among protected works. Loopholes in the IP law and its amendments must be removed for proper working of the enforcement machinery.

IT vendors have also called for strict patent laws against the growing counterfeit trade in IT sector. According to Dr. R A Mashelkar, director-general, CSIR. "Emergence of India as global destination for R&D, this emergence should be consolidated with strong IPR regime to show our commitment to global economy."

India should effectively implement IPR law to become dominant to harness intellectual capital providing proper protection. The US experts opined that Indian IPR laws are good but implementation is bad. Doris Estelle Long of the John Marshal Law School in United States commented, "Indian IPR and Copyright are good but their implementation is tardy because there is no central agency as in United States." We need to have special prosecutors for IPR law violations and more significantly IPR laws must be implemented strictly and effectively.

Need of Data and Research Collection

There are substantial gaps in the knowledge base available to policy makers who must grapple with the problems raised by digital intellectual property. In some cases, there has been little or no inquiry, while in others there are questions about the reliability of the information available.

Economics of Copyright: Research should be conducted to characterize the economic impacts of copyright. Such research might consider, among other things, the impact of network effects in information industries and how digital networks are changing transaction costs.

Chapter - III

Protection of Trademark

An Overview

A trademark used by an organization to identify its goods and services are one of its most important and valuable assets. They guarantee the source and the quality of the organisation's good and services. Satisfied customers are reassured, by the presence of the trademark, that subsequent purchases will be from the same source and to the same standard as the first. Trademark also serve the distinguish between the goods (services) of competing organizations. They can be a powerful, commercial weapon against fair competition and powerful, legal weapon against the unfair competition. In the care of goods (services) protected by a patent, the build up trademarks reputation, through sales and advertising, during the period of patent monopoly, can slow or, in some cases, event prevent the erosion of market share that usually follows the end of patents life it is the aim of this chapter to explain the importance and value of trademarks to our business clients and colleagues. The chapter first examine what is trademark is and the various type of trademarks. That are available to identify a particular product (service). Than its show how a new trademark should be chosen and cleared for introduction to the market. After that how to use trademark correctly, what is process of registration so that it retains it values as assets. This will be followed by a brief look at trademarks licences and assignments and the developing subject of comparative advertising.

Finally the legal remedies that are available to the owner of a trademark to prevent unfair or illegal competition will be considers.

Concept and Definitions of Trademarks

A trademark is a means of identification. It has visual symbol in the form of word, a device, or a label applied to articles of commerce with view to indicate to the purchasing power that they are the goods manufactured or dealt in by other persons. Trademark is a mark used a proposed to be used in relation to goods¹, it is not to registered trademarks but it must be a mark in relation to goods.² In other words a person who sells goods under particular trademark, in relation to the goods. We can say that in another words trademarks is visual representation attached to goods for the purpose of indicating their trader origin. A trademark can be word, a logo, a number, a letter, a slogan, a sound, a colour, or sometimes even "SM" identify the source of goods and /or services with which the trademark used. Trademarks can be owned or companies and should be registered at a governmental agency, which is usually referred to as the trader when a trademark is used in connection with service. It is sometime referred to as a "Service mark". The registration symbol - the latter "R" in circle ® - may not be used unless the trademark with which it is has been actually registered with the governmental agency alluded to

¹ Section 2(v) (31)

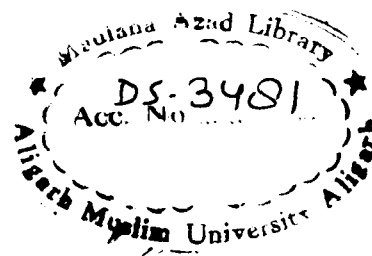
² KT Pavanny v/s K.T. Mathew, AIR 1942.

above. It has four primary functions. The first is to signify that all goods bearing the trademark come from a single source. The second is to convey to the buying public a guarantee of quality. The consumer should know that from, purchase to purchase, the favourable characteristics of the goods bearing the trademark remain the same. The third is to allow one trader to distinguish his goods from those of his competitors. The fourth is to promote the goods. It is important to realize trademarks are property, just a buildings and machinery are property. They should therefore be treated with the same respect as these, more obvious, tenable form of the property. This type of property to which trademark belonging to known as intellectual property. This term also encompasses patents, which protect inventions (useful advances), registered designs, which protect the shape or surface decoration of articles and copyright, which protect artistic or literacy works. Whilst a product may also be protected by some, or even all of these other property rights, its source and quality is always identified by its trademark.

Types of Trademark

A trademark may be:

(a) Word or words (Known or invented). This is the primary source of trademark. The majority of the world's most famous trademarks, consist of one or more words marks being of the modern age, word



marks may consist of known words, perhaps gleaned from a dictionary, a book of Greek mythology or an astronomical publication. They may be miss-spelling of such known words or they may be invented words having either no meaning or perhaps a hidden meaning which only becomes apparent when the mark is attached to the goods e.g.

Birds eye	Nike
Channel	Orange
Chevroles	Pepsi
Coke	Porsche
Hoeverprozae	prozae
Kodak	Rayban
Lucosie	Reebok
Lego	Relex
Mar/boro	Sony

B. Pictorial Device (logo)

Pictorial device can be a powerful means of product recognition particularly in cases where language or lack of literacy may be concerned.

Esso	Tiger
International Olympic committee	Five rings

Kellogg's

Cockerel

Lloyds TSB

Black Horse

Mercedes Benz

Bonnet Star

Michelin

Tyreman

Renaut

Diamond

Shell

Shell

C. Letters and Numerals

One or two letters and/or numerals generally lack distinctiveness without use. With use, however, such marks may become distinctive. With widespread use, they can become world famous.

BP

Petroleum product

4711

Perfumery

501

Jeans

57

Food product

MTV

Music broad casting

No5

Perfumery

Q8

Petroleum product

XXXX

Alcoholic beverages

D. Colour

Another means of product recognition, which if employed wisely, can minimize the amount of market share taken by generic competitors.

Heinz	Turquoise packing
Duracell	Black and Gold Batteries
Esso	Blue parafud
Signal	Red striped Toothpaste
Owens-corning	Pink Fibre glass insulation

E. Shapes

As with colours, distinctive shape can inhibit the inroads made by generic competition.

Cointrean	Liqueur bottle
Dimple	Whisky Bottle
Jif	Plastic lemon
Toblerone	Chocolate bar
Toilet-Duck	Disinfectant

F. Slogans

Although slogan tends to be used as means of advertising a product, they may become so well known that they also identify the product.

Example

Orange	The future bright, the future's orange
Coca-cola	it's a real thing
Kellogg's cornflakes	The sunshine breakfast
Pedigree chum	top breeders recommend it
Audi	Vorsprung Durch Technique
British air ways	The worlds' Favourite Airlines
Pepsi	<i>Yes peyas hai baree</i>

G. Sounds and Smell

More exotic than the trademark listed above. However there is no reason, in principle, why a distinctive advertising jingle or a distinctive smell, associated with a product such as a disinfectant, should not qualify as a trademark.

Example

Direct line Jingle	Direct licence insurance
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Air on a to string

Hamlet Cigars

Flower Duct from Lakme

British Airways

The clearance of a trademark for use and registration

When choosing a new, distinctive trademark to be used in new product, the company and individual making the choice should want to know the answer the fundamental question.

1. Am I free to use the trademark chosen on the product in view of earlier trademark that are either already in use or intended to use?
2. Will I be able to registered my trademark chosen on the elsewhere thereby increasing my level of protection against unfair competition?

These question are best answered by a professional trademark advisor, who is trained to compare the chosen trademark with potentially conflicting trademarks owned by other company/individual, to asses the commercial risk of bringing of new mark into use and estimate the likelihood of successfully registering the mark.

How to use Trademark Correctly

Trademarks are property, just like building and machinery. Everyone realizes that, through neglect building and machinery can

become dilapidated or unusable. However, it is often forgotten that, through lack of use or misuse, a trademark can also lose value. In extreme case of misuse, the trademark can become a mere generic description of a product, with no commercial value at all. This could have a more devastating effect on a business than any natural disaster.

Set out below are some important do's and don'ts of trademark usage provided they are followed in written documents and, where appropriate, in speech, the dooms day scenario set out above should be avoided.

a. Ensure that the trademark stand out from its surroundings. This can be achieved by employing atleast one of the following simple technique.

1. Write the first letter of each word in a trademark as a capital letter.
2. Write the whole trademark in a capital letters.
3. Use an unusual type fall, such as Italics, for the trademark.
4. Use bold colour lettering for trademark

(b) Use of trademark in association with a generic description of the product.

This should ensure that the consuming public are aware of the trademark nature of the trademark. In other words, that the trademark is not generic description of the goods.

This is a particularly important rule for novel patented products that are sold for a long period without competition. It is important in such a case, to think of an appropriate generic description of the new product as it is think of a trademark for the product. If this is not done, there is a real danger, once the patent expire, that the trademark will be seen by trade as the generic names if you doubts this consider the fate of cellophone, escalator and gramophone, all once well-known trademarks; but now generic names.

Example of correct use

Solar system Chocolate bar

Zeus Washing powder

Corker Wine bottle opener with the revolutionary, patented
action.

C. Identify the trademark and its ownership.

This identification can be achieved as follows:

I place "SM" or "TM" or ® superscript after the trademark.
"SM" may be used to identify both registered unregistered service
marks "TM" may be used to identify both registered and unregistered

trademark, for goods. ® may only be used identify registered trademarks (but may be used in relation to goods, and services). In a number of countries, it is criminal offence, to identify an unregistered trademark with the symbol ® it follows that many companies which global marketing interests, use of "SM" and "TM" to identify their trademarks, both registered and unregistered.

Trade Mark Licences and Assignments

As mentioned before, trademarks are property. This means that they can be treated, in legal terms, in much the same way as real property, such as a house. To illustrate this further, let us consider how the owner of a registered trademark can benefit from his ownership of such an asset and compare this with the right enjoyed by a home owner. First, the trademark owner may use the mark himself on the goods for which it is registered, to the exclusion of others. Clearly, this is comparable to a home owner who lives in his own property.

Alternatively, a trademark owner may licence the use of his mark, under agreed conditions, to a third party. This is very similar to a homeowner who decides to let out his property, in return for rent.

This is obviously analogous to the sale of a house. In order to illustrate the type of trademark agreements that may be made,

however, we will no consider, in more detail, the position in the UK, which is regulated by the 1994 Trade Marks Act.

Unregistered Trademark Rights and Passing Off

Much of the previous discussion has concentrated on the value of and the rights attached to registered trademarks. This is understandable given that recent changes in trade mark laws around the world have widened the definition of the type of trade mark that may be registered (in some cases, to include shapes for the first time), increased the area of protection that is available to the registered trade mark owner and generally boosted the importance of registration still further.

It should not be forgotten, however, that a registered trade mark that is never brought into use has little or no intrinsic value. It is only through use, in relation to particular goods that a trade mark becomes of some worth to its owner. The trade mark becoming the symbol of a product's reputation or goodwill. The UK, along with other developing countries like India and Pakistan that follow the UK's legal tradition, recognize the separate nature of trade mark rights derived by use and by registration. Such unregistered trade mark rights may also allow their owner to prevent or stop unfair trade practices, by is competitors, either when he has no registered rights or when his registered trade mark rights are unsuited to the task.

To illustrate this, let us consider following hypothetical examples.

Company P has sold Tiger sports shoes for many years in large numbers throughout the UK. It is company policy, however, not to register trade marks. A competitor, company Q, beings selling sport shoes under their own Q brand, but with figure of a tiger on the side of each shoes. P wishes to prevent Q's use of the tiger device as soon as possible, since the early indications are that Q's product is damaging the sale of Tiger sports shoes significantly. In these circumstances, P must bring a passing off action against Q, based on their (P's) reputation and goodwill (common law rights) in the trademark Tiger that have been derived by use. P should also seek an interim injunction, under which Q will be prevented from using the Tiger logo until the full Court case has been decides.

The difficulty faced by P, if Q decides to fight the case, is that passing off actions are usually very hard to win. P must not only show that the word Tiger is exclusively associated with them in the minds of the purchasing public and that Q's activities are damaging their sales, but also that there is confusion between the product sold under the word mark Tiger and the product sold under the combination of Q and a tiger logo, leading purchasers either to buy Q's product by mistake or to believe that Q's product is, in some way, connected with P. Such confusion (the result of a deception) is notoriously difficult and expensive to prove, usually requiring extensive survey evidence.

This is the major drawback of attempting to enforce unregistered trade mark rights in a passing off action. P would have been spared much of this trouble and expense, if they had registered their mark Tiger, well before q appeared on the scene.

Infringement of Trademark

A registered trademark is infringed by a person who, not being a registered proprietor of a trademark or a registered owner thereof using by way of permitted use, uses in the course of trade, a mark which is identical with or deceptively similar to the trademark in relation to any goods in respect of which the trademark is registered and in such manner so as to render the use of the mark likely to be taken as being used as a trademark. Unregistered owner of the trademark are also entitled to protection of their marks under the scheme of the Act. Therefore, in order to prevail in a trademark infringement claim, the claimant must show that:

- (i) The marks, is protectable under the provision of the trade and merchandise marks Acts;
- (ii) The defendant is using the same or similar marks;
- (iii) The defendant is likely to cause consumer confusion regarding the origin of the goods.

Although the first two issues are necessary for the finding of an infringement, the central question in any infringement case is

whether there is a substantial likelihood of consumer confusion due to the similarity between the marks. It is also important to note that the registration of a trademark can be subject to the disclaimer³ if a trademark contains any matter which is common to the trade or is otherwise of a non distinctive character, registration may be granted, subject to the condition that the proprietor shall disclaim any right to the exclusive use of such part or of all or any portion of such matter further, when a mark is registered subject to such limitation the use of mark in a manner to which the registration does not extend, would not constitute an act of infringement.⁴

In the light of above legal provisions, it is to be examined whether cyber squatting would amount to trademark violation.

The trademark law seeks to provide effective protection of trademark⁵ and prevents the use of protection fraudulent marks on merchandise.⁶ State that the Act seeks to prevent consumer confusion as to the source of particular goods and services by prohibiting a subsequent competing business from using an identical or extremely similar product or symbol a previous competitor.⁷

Under the Act registered trademark is infringed by a person who not being a registered proprietor of a trademark or a registered owner

³ Section 17 of the trade and merchandise mark Act, 1958.

⁴ Section 30(1) of the Marchandise Act 1958.

⁵ Statement of object and reason to the Act

⁶ Preamble to the Act.

⁷ The Act provides that for the prohibition of registration.

thereof using of by way of permitted use, uses in the course of trade, a mark which is identical with or deceptively similar to the trademark in relation to any goods in respect of which the trademark is registered and in such manner so as to render the use of the mark likely to be taken as being used as a trademark. Unregistered owners of trademarks are also entitled to protection of their marks under the scheme of the Act. Therefore, in order to prevail a registered trademark or a mark used in relation to goods for the purpose of indication or so as to indicate a connection in the course of trade between the goods and the some person having a right as proprietor to use the trademark and in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indication or so as to indicate a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user, or use the trade mark whether with or without any indication of the identify of that person, and include a certification trademark registered as such under the provisions of chapter VIII.

Essentially, trademark are names and symbol that a company uses to identify its goods or service in the market place trademark

identify the source of the product and also help indicate the quality of a product or service.⁸

A. Availability of Trademark for Registration

Procedure for Registration

The foremost conditions in the registration process for the registration is the desire of the persons to register the trade mark. Before seeking registration the person should either be the proprietor⁹ of the trademark or the same must be proposed to be used by him in respect of goods and services. The surest means of acquiring affective trade mark right to obtain registration and also to be used the mark on goods or relates to services in India.

The procedure for registration of trademark is enumerated in section 18 to 23 of the 1999 Act. Section 18(1) and (2) read as follows:

1. 118 (1) Any person claiming to be proprietor of trademark used or proposed to be used by him, who is desirous of a trademark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to be registrar in the prescribed manner for the registration of the trademark.

⁸ Tanner Miched, Trademark, Internet domain names and the NSI: how do we fix a system that is already broken? Journal of Technology Law and Policy 3(2) 1998.

⁹ A person may be prepare of even unregistered trademark. The application may be made in the name of individual partners of a firm, corporation, any government department a tourist joint application.

2. A single application may be made for registration of trademark different classes of goods and services and fee payable therefore, shall be in respect of each such classes of goods and services.

An application for registration of trademark may be made for one more particular goods included in one or more classes of goods or services¹⁰ Registrar is determine to classify the good and services. In case of any durable the decision of registrar is final.

The goods and services on which trademark is used or is proposed to be used may belong to different classes as are classified by the registrar in term of S 17(1). The trademark Act 1999 allows a single application to be made for registration of trademark for goods and services, falling more than one classes of goods and services.¹¹ However the application fee shall be payable in respect of each such class of goods or services to which the goods and services belong.

The provision of S/18(2) does not make it clear that the application for registration of trademark still not used by him, this shall operate as a claim on the trademark, till the time applicant does not abandon his claim. If another person makes an application for a

¹⁰ A Registrar shall classify the goods and services section 7 and on an alphabetical index and sector 8. Till trade & merchandise Act, 1950, Fourth Schedule to the rules.

¹¹ S/18(2) of the trademark Act 1999, S/18(2) of trade and merchandise marks Act 1958. For schedule to the rule has class of goods. The classification adopted in the fourth schedule is substantially as the same as International Classification of goods adopted by the U.K., France and other European countries.

similar trademark than the claim of early applicant is superior and will be preformed.

A joint application may also be filled, where there is relation between one or more person interested in trademark in such that now of them is entitled between oneself and the other and other of them to used the trademark (a) on, behalf of both or all of them (b) in relation to the articles or services with which both or all of them are connected in the course of trade such person may be registered as a joint proprietor of trademark.¹²

Who can file application

A regal and natural person can apply for a trademark protection which includes an individual, proprietor and partnership firms, association of a persons and a company, whether national or foreign National.

Advise as a distinctiveness and search for similar marks.

S/133 provides for the applicant to obtain information by making an application in the prescribed for if the proposed trademark in prima-facie distinctive, making before making an application for registration. The advice expressed by registrar is not conclusive - Kala Niketan vs Kal Niketan¹³ If a person wants to know whether the mark selected by him for registration resembles any trade already records, he may

¹² S/18(2) of the trademark Act 1999, S/18(2) of trade and merchandise marks Act 1958.

¹³ AIR 1983 Del 161 at 166.

make a request for a search and obtain a search report from the registrar. If a favourable report is given and he makes an application for registration of the mark, the registrar can still and lake objection.

Malafide intention must not to use

S/47 (1) (a) of a trademark Act, 1999 enable, any aggrieved person to apply to the registrar or to the Appellate Board take off a registered trademark from the register if the trademark registered with malafied intention on the part of the applicant to use the trade mark on goods or services stated in the application. The sprite of the provision is that either the proprietor should established a bonafied intention to use the trademark at the time application or he should actually used the trademark. Otherwise the trademark, even if registered, may taken off the registrar.

After the acceptance of application the application is advertised in the trademark journal.

Any person may, within three month from the date of the advertisement or re-advertisement of the application for registration or within such further period not exceeding one month, give notice in writing the registrar, of opposition to the registration.

The registrar shall serve a copy of the notice of apposition on the applicant for registration within two months from the receipt by the applicant of such copy of the notice opposition, the applicant shall

send a counter statement on the ground on which application relies to the registrar.

Duration of trademark

According to the section 25 of the 1999 Act provides that a trade mark is registered from the date of the registration application for a period of 10 years¹⁴ on the expiration of the period of 10 years, the registered proprietor or an assignee¹⁵ can obtain renewal on payment of prescribed manner and period. The trademark can be further renewed identify by following the same procedure on each expiration of registration¹⁶. For the benefit of trademarks owners, the registrar is required to give notice for payment of fee stating data of expiration of trademark so to avoid inadvertent lapses or delay in making the application or payment of renewal fee.¹⁷

Hearing of the parties

The registrar call up the two parties with their evidence. In case the decision goes infavour of the applicant is free to appeal then the trademark is registered in the name of the proprietor. But in case the decision goes against the applicant than the applicant to the High

¹⁴ S /20 of trademark Act 1999; Earlier it was for seven years under S/25 (1) of trade merchandise Marks Act, 1958.

¹⁵ If the application made by assignee, the application must be accompanied for registration subsequent proprietor Sev BIJDI vs Sperieer 1983 PTC 237 at 244.

¹⁶ S/25 (2) of Trademark Act 1999.

¹⁷ S/25(3) of Trademark Act 1997.

Court. The High has power to uphold or modify or struck down the decision of the registrar.

Assignment and Transmission

Assignment and transmission can be made with goodwill or without good will of the business in respect of the same or some of the goods for which the trademark is registered.

S/2 (i) (b) defines assignment as "assignment in writing by Act of parties concerned section 2(1) (zc) state that transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment.¹⁸ A registered proprietor can assign only the rights conferred upon him by registration. An assignment is, therefore, subject to be condition and limitation, if any, entered on the register at the time of registration of the mark or subsequently. In particular assignment is subject to those rights, which from the register appear to be vested to any other person.

The assignment cannot affect the rights of proprietors of identical or similar marks appearing on the register.

The power to assign is given to the registered proprietor. According to section 37, the person who is the registered proprietor of trademark, for the time being has got such power. Thus,

¹⁸ The two expressions have been similarly defined in trade and merchandise market, 1998 S/2 (1) (a) and (b)

only the power whose name is entered in the registered as the registered proprietor can assign the trademark. It appears that even the mark was registered in the wrong name, the assignment by such a person whose name has been wrongly entered may not be questioned or refuted on the ground.

The trademark and goodwill of business need not necessarily be assigned simultaneously. A person may merely assign the trademark without the good will of business need not necessarily be assigned simultaneously. A person may merely assign the trademark without the good will of concerned business. S/38 makes provision for assignment of registered trademark, whereas S/39 allow the same for unregistered trademark splitting of trademark on the basis of goods or services is permitted. However, the conditions of S/42 of have to be followed. In trade and merchandise mark Act, 1958 on assignment of unregistered trademark had to full certain conditions. However, trademarks, Act, 1999 has changed the position and now even unregistered trademark can be assign without goodwill without subjecting it any condition excepts those mention in S/40 and 4.¹⁹

The assignment of trademark need not necessarily relate to the whole of good or services for which the mark in registered but may be confined to only part of the goods and services.²⁰

¹⁹ S/39 of Trademark Act, 1999.

²⁰ Section 39 of Trademarks Act, 1999 (See 37 of trade and merchandise marks Act 1958).

No assignment or transmission of a certification trademark can be made without the consent of the registrar.²¹

Associated trademark cannot be assigned separately and are assignable or transmissible only as a whole.²² We can say that in another words associated trade mark is not assignable or transmissible except as a whole and not separately. For all other purposes under the Act, however such trademarks shall be deemed to be, have been registered as separate trademark.

Position of unregistered trademark

Unregistered Trademark may be assigned and transmitted with or without the goodwill of the business concerned. Earlier such assignment or transmission without goodwill used to be different footing.

Section 39 of the trademark Act, 1999 has simplified the provision in relation to of unregistered trademark without goodwill. It lay down that an unregistered trademark also be assigned with or without goodwill. Section 42 of the 1999 Act lays down conditions for assignment of trademark without the goodwill of business such assignment however would take effect when the assigner obtain direction of the registrars and advertise the same in terms of the direction of the registrar according to the prescribed procedure

²¹ S/43 of Trademark Act, 1991.

²² Section 44 of the Trademark Act 1999.

unregistered and registered trade mark both are subject to same conditions.

Section 38 of 1958 Act provided for assignment of transmission of an unregistered trademark without goodwill of the following conditions.

1. Used in the same business.
2. Assigned at the same time to same person as registered trademark.
3. Used on same goods as registered trademark.

Thus the unregistered trademark has been coupled with registered trademark with regard to goods, business, time and person.

Rectification or Cancellation of a Trademark

Any registered trademarked can be cancelled or varied at the instance of any aggrieved person on the ground of any contravention or failure to observe any condition of registration.

Any person aggrieved by the absence or omission section 56 provides the general terms for the rectification of the registered (part of 8 parts) by a person aggrieved by absent or omission of any entry in the register or by any entry wrongly remaining in it or by any error or defect of any entry in the registered. There are special provisions for the rectification of registered in case of defensively registered

trademark (S/47 (4) and (5)) for certification trademark (Sec 69) and on the ground of non use (S/46). Section 57 provides that's registrar has authorized to correct errors, effect any change in name and address, cancel any entry, strikeouts any goods from the registered specification and enter a disclaimer or memorandum relating to the trademark. Section 58 deals with making additions to and alteration of a registered trademark not substantially affecting its identity and S/59 deals with the classifications of goods. The provision of S/56 are subject to section 32 which provides that subject to certain exception in the original registered of a trademark registered in part A is, after the expiration of 7 years from the date of the original registration.

Upon an application filed by aggrieved parties before High Court²³ or to registrar, the High Court or the registrar may order cancellation of the registration of trademark due to reason of bonafied continuous use of a trademark in respect of goods, it is registered for the personal of 7 yr or more from the date of application. But in a suit for infringement of a registered trademark, if the validity of registration either party marked in questioned, the issue as to validity can be determined only an application for rectification made to High Court.²⁴ Subject to the provision of section 107 (1) where an application is made to the registrar for the rectification of register of register under section 46, 47 (4) or 56, by

²³ Section 107 4/Section 3 which defines the Jurisdiction of High Court.

²⁴ Section 107.

the registrar may think fit refer the application at any stage of proceeding to the High Court.²⁵

C. Protection and Enforcement of IP and TRIPS Agreement

The agreement on Trade related aspects of intellectual property rights (TRIPS) are divided into seven Chapter. Where as parts I and II contain norms of substantiate protection III (and to some extent part IV) incorporates provisions or enforcement of Intellectual Property Rights.

The aim of the provision of the enforcement is to ensure the undisturbed the IPR, which find their place in the substantive provisions. All TRIPS member (WTO member) are required to give effect to the provisions under their national laws. The TRIPS agreement has thus, harmonized the law on the protection and enforcement of IPRS. As in the case of substantive standards, the United States standards were made the basis on enforcement measures.

Since, the TRIPS agreement was adopted mainly to "correct" the status of IPR, in developing countries, who never had very strong traditions of protection and enforcement of IPR before the TRIPs was Concluded, the application of the provisions on enforcement by these countries hold a special clue on the efficacy of the TRIPs agreement in

²⁵ Section 107 (2)

general. Failure to protect and enforce the IPRs would flustered the efforts of the developed countries to substantive their comparative advantage in the knowledge based industry. These countries perceive that the existence and enforcement of IPR in right earnest can only ensure foreign investment and technology transfer to developing countries²⁶ under the TRIPS developing countries are required to enact the requisite laws to give effect to their obligation by the end of transition period.²⁷

Though the TRIPS "take" into account differences in national legal system for enforcement, but under the restrictive region of the GATT/TRIPS, these differences may create tensions between the member state, when the aggrieved sees the nullification and impairment of its right because of the inadequate enforcement. This would inevitably create a conflict situation between the TRIPS members. The TRIPS procedure on enforcement and India's efforts to make its law TRIPS complaint in this regard. Part I of the TRIPS on "General Provision and basic principles" contains a total of 40 articles (Article 1-40) divided into eight section: deal with the nature and scope of obligations; (Article 1), intellectual property conventions (Article 2), national treatment (Article 3); most favoured-nation treatment (Article 4), multilateral agreement on acquisition or

²⁶ See, Gail E Evans, "Intellectual Property Rights, Investment of Trade."

²⁷ See, Gail E Evans, "Intellectual Property Rights, Investment of Trade."

maintenance of protections (Article 5); exhaustion (Article 6) objectives (Article 7); principles (Article 8).

For the purpose of this agreement the term “intellectual property” refers to all categories of intellectual property that are subject of section 1 through 7 of part II.

Members shall accord the treatment provided for in this agreement to the nationals of the other members.²⁸

In respect of the relevant intellectual property rights, the national and other members shall be understood as those natural or legal persons that would meet the criteria for the eligibility for the protection provided for in the Paris Convention (1967), the Berne Convention 1971, the Rome Convention and the Treaty on intellectual property in respect of integral circuits, were all the members of those OS Convention.²⁹

Any member availing itself of the possibilities provided in paragraph 3 of Article 5 or paragraph 2 of Article 6 of the Rome Convention shall make notification as for seen in those provision to

²⁸ When national are referred in this agreement, they shall be deemed, in the case of a separate customs territory members of the WTO to mean persons, natural, or legal who are domiciled or who have a real and effective industrial or commercial establishment in that custom territory.

²⁹ In this agreement, “Paris Convention” refers to the Paris Convention for the protection of Industrial property”. Paris Convention refers to the Stockholm Act of this convention of 14 July 1967. “Berne convention” refers to the Berne convention for the protection of literary and artistic works; “Berne Convention (1971)” refers to the Paris Act of this Convention of July 1971, “Rome Convention” refers to the International Convention for the protection of performance producer of phonograms and broadcasting organizations, adopted at Rome on October 1961. “Treaty on Intellectual property in respect of Integrated circuits” (IPIC) refers to the treaty on intellectual property in respect of Integrated circuits, adopted at Washington on 26 May 1989. “WTO Agreement” refers to the agreement establishing the WTO.

the council for Trade Related Aspects of intellectual property Rights (the "Council for TRIPS).

Section 2 of part I of the TRIPS agreement deals with the Trademarks protectable subject matter (Article 15); Rights conferred (Article 16) exceptions (Article 17) terms of protection (Article 18); requirement of use (Article 19); other requirements (Article 20) Licencing and Assignment (Article 21).

According to Article 18 the initial study and each renewal of registration shall be for a term of no less than seven years. The registration of trademark shall be renewed indefinitely. Part III of the TRIPS "enforcement" of Intellectual Property Rights contains 21 Articles (Article 41-61) divided into five sections:

General Obligations (Article 41)

Article 41 sets out the basic obligations of the members to establish an effective enforcement procedure for IPRS, incorporated in the TRIPS, including expeditious remedies, which must act as a deterrent to further infringements.

Members shall ensure that enforcement procedures as specified in this Part are available under their national laws so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a

deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

This provision is widely worded and imposes an obligation on the members to provide enforcement procedures under their national laws, but the specifications of those procedures are left to the members, with a rider saying, "so as to permit effective action against any act of infringement." It is up to the members to decide about the exact measures and to ensure their effectiveness in practice. Moreover, in giving effect to these procedures, the members are not obliged "to put in place a judicial system for the enforcement of intellectual property right distinct from that for the enforcement of laws in general", neither should it affect their capacity to enforce their laws in general (para 5).³⁰ They need not to specifically allocate the resources for the enforcement of IPRs. This provision, thus, accepts the different legal systems for enforcement among the members, which also finds its mention in the preamble para (c) to the TRIPs. Hence, the effectiveness of the enforcement measures depends to a large extent on national legislature and practice that should not be subjected to pressure from outside. The provision has infact soft-

³⁰ This provision was contrary to the US proposal, See GATT DOC.MTN.GMG/NG/CO/14/Rev. 1 of 17 October of 1998 at 13, reproduced in Beire and Shriker, super not 3 at 197, but it was in line with the position adopted by India in particular, see GATT, DOC, MTN.GNC/NG/11/w/40 of September 1981, at 3.

pedaled the absoluteness of the obligation on enforcement procedures.

The procedure which the members are required to provide, should be "fair and equitable", "not unnecessarily complicated or costly, or entail unreasonable time limits or unwarranted delays." Further provisions have tried to give content to these terms. Accordingly, decisions on the merits of the case should preferably be in writing and reasoned and be made available to the parties without delay. The courts must base their decision on evidence only in respect of which parties were offered the opportunity to be heard.³¹ There should be an opportunity for review by a judicial authority of final administrative decisions, and subject to the jurisdictional provisions in national laws (which may not provide so), of initial judicial decisions on merits. However, member is not obliged to provide an opportunity for review of acquittals in criminal cases.³²

Civil and Administrative provisions (Article 42-49)

The general obligation to provide "fair and equitable procedures" to right-holders in para 2 of article 41 has been detailed in section 2 of part III. For the purposes of this part, the term "right-holders" includes federations and associations having legal standing to

³¹ Compare Article 17 (3) of the NAFTA agreement of Dec. 1992.

³² Para 4.

assert such rights,³³ thereby giving copyright collecting societies and other bodies a collective legal standing in intellectual property matters.

The fair and equitable procedures, in accordance with article 42, must provide the holders an access to civil judicial procedures to enforce their IPRs. Defendants should have the right to written notice, which is timely and contains sufficient details, including the basis of the claims. The parties must be allowed to be represented by independent legal counsel and overly burden some requirements concerning mandatory personal appearances must not be imposed. All parties to such procedures should be entitled to substantiate their claims and present all relevant evidence; the opposite party must be required to produce evidence, which are in its possession.³⁴ There is also the obligation "to identify and protect" confidential information in accordance with the relevant constitutional provisions.³⁵ Where a party to the proceeding "without any good reason refuses access to, or otherwise does not provide necessary information with a reasonable period, or significantly impedes a procedure relating to an enforcement action," the judicial authorities may be empowered to make a preliminary or a final determination in the matter on the basis of information available, subject to allowing the parties to be heard

³³ See FN.11 of TRIPS agreement in Article 42.

³⁴ Article 43.

³⁵ Article 42.

on the allegations or evidence.³⁶ Thus, the members have the discretion to give effect to this provision.

Articles 44-46 detail the remedies that should be made available to an aggrieved party. These provisions are novel because for the first time and international convention on IPRS provides rules on compensation and other sanctions.³⁷ As a first-measure, the judicial authorities shall issue an injunction order to restrain a party from an infringing activity. But where the party has indulged in the infringing activity, without the knowledge of infringement, the members are not obliged to provide for injunction. However, the members are free to restrict the right of the right-holder in cases in which the government or a third party, authorized by the government, uses the protected subject matter of the right without the consent of the right-holder, to payment of appropriate remuneration in accordance with article 31(h).³⁸ In all other cases, declaratory judgments and adequate compensation shall be available.³⁹ Where the infringer "knew or had reasonable grounds to know that he was engaged in infringing activity" and thus proves his *malafide*, the judicial authorities shall award adequate damages to compensate the right-holder for the injury suffered by him, and in appropriate cases, may order for the

³⁶ Article 43(20).

³⁷ See Supra Note 5 for other IP conventions.

³⁸ Where the government issues a compulsory licence, Article 31(h) states that right holder shall be paid adequate remuneration in the circumstances of each case, taking into account economic value of the authorization.

³⁹ Article 44.

refund of cost of the proceedings, including attorney's fees. It also means that if the complainant loses the case, then the defendant will also be entitled to attorney's fees, particularly where the right-holder had abused the legal procedure and restrained the defendant from enjoying his lawful right.⁴⁰ Where the infringer did not know or had no reasonable grounds to know that he was engaged in infringing activity, the order for recovery of profits and/or payment of pre-established damages may be passed.⁴¹ Thus, to provide remedies of injunction and pre-determined damages to the aggrieved party are not mandatory on the member state.

The judicial authorities shall further be empowered to order that infringing goods must be disposed off outside the channels of commerce, or be destroyed in accordance with the law. The materials and implements, which were "predominantly" used in the creation of the infringing goods, must be ordered to be removed from the channels of commerce without any kind of compensation.⁴² In giving such order, however, the interests of the third parties should be taken into account.⁴³ Members may (at their discretion) authorize the judicial authorities to seek information from the infringer about the identity of third parties involved in the production and distribution of

⁴⁰ Article 48 (1).

⁴¹ Article 45.

⁴² In the case of trademark which were unlawfully affixed, simple removal may not be sufficient to permit their release into the channels of commerce. The risk that the trademark may be reaffixed, cannot be ruled out.

⁴³ Article 46.

the infringing goods or services and their channels of distribution.⁴⁴ However, if the civil remedies are provided through administrative procedures (rather than judicial), they should be in conformity with the provisions in articles 42-48 (art. 49).

Provisional Measures (Article 50)

In order to provide an immediate relief to the right-holder against an infringing act, the TRIPS Agreement provides provisional measures, which were very much emphasized by the industrialized countries during the TRIPs negotiations.⁴⁵ Article 50 (the only article on this aspects) outlines the minimum requirements to be adhered by the TRIPS members in the proceedings for provisional protection of IPRS.

Accordingly, the members are obliged to provide prompt and effective provisional measures to prevent the infringement of IPRS, particularly to prevent the entry of goods, including imported goods into channels of commerce in their jurisdiction immediately after customs clearance. The judicial authorities should be empowered to order measures for the preservation of relevant evidence regarding the alleged infringement.⁴⁶ In order to satisfy themselves "with a sufficient degree of certainty" about the right-holder's claim about his

⁴⁴ Article 47.

⁴⁵ See, the US position paper, Supra note 11; and European proposal, GATT DUC-MTN, GNG/NG11/W/16, of 20 November, 1987, in Berier and Shriccker, Supra not 3 at 2001.

⁴⁶ Article 50 (1).

right being infringed or infringement is imminent, the judicial authorities shall have the authority to “require the applicant to provide any reasonably available evidence” in support of his claim and “any other information necessary for the identification of goods concerned” (para 3 and 5). On the other hand, in order to check the abuse of provisional measures and to protect the interests of the defendant, the applicant may be asked to provide a security or equivalent assurance.⁴⁷

Most significantly, the judicial authorities must empowered, where appropriate, to adopt provisional measures without the defendant being heard (*naudita altera parte*), in particular where delay is likely to cause irreparable damage to the right-holder or where there is a demonstrable risk of evidence being destroyed.⁴³ This is similar to *Anton Piller* order followed in the United Kingdom and other commonwealth countries, whose purpose is to preserve the evidence by preventing the destruction or concealment of evidence by an alleged wrongdoer.⁴⁸

However, in such cases, the affected party must be informed without delay after such measures have been executed. After being informed, the defendant may request a review of the measures,

⁴⁷ Para 3.

⁴³ Para 2.

⁴⁸ This provision obviously does not talk about the persistent infringement. *Anton Piller* order, named after the case of *Anton Pillar KG V/s Manufacturing processes Ltd.* (1976). Ch55, in the order of the competent court permitting the complainant party to enter the premises of alleged wrongdoer and remove material which is evidentially important .

including the right to be heard, in order to decide whether these measures should be modified, revoked or confirmed. Review must take place within a reasonable period after the notification of the measures.⁴⁹ The provisional measures shall be revoked on the request of the defendant or otherwise cease to have effect if the proceedings concerning the merits of the case are not initiated within a reasonable period of time as determined by the judicial authorities, and in the absence of such a determination, within twenty working days or thirty-one calendar days (whichever is longer).⁵⁰ In such a case, and in case the provisional measures are revoked, or where the applicant's action remains unsuccessful, the defendant may be entitled to appropriate compensation from the complainant.⁵¹ Provisional measures ordered through administrative procedures must also conform to the above-said provisional measures.⁵²

Special requirements related to border measures (Article 50-60)

Border measures against infringing goods have been given an elaborate treatment because of the developed countries special emphasis to check product piracy in trademark and copyright work. Specific obligations have been imposed on members to institute and enforce border measures to prevent infringement of IPRS. These border measures, however, are not to be applied between the

⁴⁹ Para 4.

⁵⁰ Para 5.

⁵¹ Para 7.

⁵² Para 8.

members forming part of a customs union (viz., EU)⁵³ or where the imported goods put on the market by with the consent of the right holder.⁵⁴ perfectly understandable under the issue of exhaustion, which is left undecided under article 6 of the TRIPS agreement. A member is thus not obligation to apply border measures to goods protected within its own country that have been put into circulation in another country by the right-holder or with his consent. Goods in transit are similarly exempted from border measures, as well as de minimise imports, i.e., small quantities of goods carried in travelers personal luggage or sent in small consignments, and left to the member's discretion (art. 60).

The border measures, which the members are required to take, are specified as under:

- (1) If the right-holder has valid grounds for suspecting the importation of infringing goods, he must request the competent authorities to order for the suspension of the release of those goods (art. 51)
- (2) The right-holder, while making such a request, must present adequate evidence which should prima facie establish his claim, and to supply a sufficiently detailed description of his goods to

⁵³ See 2 appended to Article 51 of the TRIPS agreement.

⁵⁴ See, f.n. 13 to TRIPS agreement, it states it is understood that there shall be no obligation to apply such procedures to imposes of goods put on the market in another country by or forth the consent of the right holders or to gods in transit.

make them readily recognizable by the customs authorities. Upon the request of the applicant, the competent authorities shall inform the applicant, within a reasonable period of time that whether they have accepted the application, and the length of time of which the requested measure will remain in force (art. 52)

(3) The competent authorities shall have the authority to order the applicant to provide a security or equivalent assurance, in order to protect the defendant and prevent any abuse of these measures, but such security or assurance should not unreasonable deter applicant to have recourse to border seizure procedures (art. 53(1)).

(4) Where the release of the goods has been suspended, both importer and the applicant must be informed promptly (art. 54). The right-holder and the importer should be given sufficient opportunity to inspect the detained goods, subject to the protection of confidential information. Where a positive decision on merits has been made in favour of the right-holder, the competent authorities may be empowered to inform the right-holder the names and addresses of the consignor, the importer and the consignee and the quantity of the goods in question (art. 57).

Enforcement by State Parties

The TRIPS agreement, for the first time, creates a multilateral framework for the enforcement of all IPRS, which was so far left to the nation-states to carry out at their discretion under their national laws. It incorporates a minimum set of basic procedural regulations to achieve “effectiveness” in the enforcement of these rights. This has created considerable differences in practice regarding numerous aspects of implementation at the national level. The TRIPS, by “taking into account differences in national legal systems” has sought uniformity on the rules of enforcement. But, whereas the objective is to achieve sufficiently effective protection through these rules, it is also the aim of the TRIPS that they should not become the barriers to free flow of goods and services (preamble). Thus, it leaves a considerable freedom to the members to give effect to these provisions under their national laws.

The provisions on enforcement, however, uses certain very vague terms as “effective”, “reasonable”, “undue”, “fair and equitable”, “unwarranted” and “not... necessarily complicated or costly”, which though leave substantial freedom to the members in giving effect to these provisions, create lot of confusion and leave unsettled the implementation as required by the system by the TRIPS. This also does not rule out the future disputes on implementation even among the developed countries. Nevertheless, according to

TRIPS, approximation on a broad basis appears necessary in the area of provisional protection and border enforcement measures. But on these aspects, differences exist even among the industrialized countries.

However, ever since the negotiations on TRIPS started, the efforts were initiated to take "effective" measures for enforcement of IPRS. IN 1986, the EEC adopted a council regulation, thereby laying down measures to prohibit the release of free circulation of counterfeit goods, which was later revised and extended to copyright goods.⁵⁵ This is being done to protect the external borders of the community and was undertaken by the members and the community jointly in pursuance of the trade policy of the community. Apart from that, no harmonization has been achieved in providing the provisions to ensure a fair and just procedure, rules regarding the submission of evidence, the right to be heard, giving the reasons for decisions, the right to appeal, interim measures and the award of damages,⁵⁶ with the result that the individual states are following their own procedures and measures to enforce the IPRS, which are often conflicting. Although the community is competent to harmonize the national rules under article 100 of the EC Treaty as they "directly affect the establishment or functioning of the common market", but

⁵⁵ EC Council Reg. No.3842/86 of Dec, 1, 1986, OJEC NO.13576 and subsequent EC council Reg. No. 3295/94 on Dec. 1994 OJEC NO. 1341 of Dec. 30, 1994.

⁵⁶ See, the ECJ, decision in the TRIPS Jurisdiction case (No.1/94) of No. 15, 1994 and 27 11 CS03 at 520 (4/1996) Para 104 of the Judgment.

the fact remains in general that "the Community institutions have not hitherto exercised their powers in the field of enforcement of intellectual property rights."⁵⁷

The North-American Free Trade Agreement (NAFTA) of December 17, 1992, which entered into force on January 1, 1994, contains detailed provisions on enforcement (1714-1718) that are modeled on the TRIPS Agreement. On the other hand, the Andean Pact countries: Bolivia, Ecuador, Peru, Colombia and Venezuela, in their decision 351 of the Cartagena Agreement of December 17, 1993, on copyright, though have left individual issues on enforcement to the national legislatures, but article 55-57 have harmonized the law on enforceability on the lines of TRIPS amongst them. Apart from general procedural principles of the right of being heard, and the impartiality of judges, these provisions provides for the effectiveness of the proceedings; the immediate cessation of infringing acts; seizure and confiscation of objects that have been employed for infringing purposes; damages and refunding of the lawyers expenses; the permanent removal from circulation of infringing copies of work; and penal sanctions.

In addition to these regional efforts, national laws of practically all the countries already contain administrative and legal provisions to grant substantive protection on the enforcement of these rights.

⁵⁷ Ibid the EC Design Regulation (OJEC No. L29 of Jan, 1994).

Section 337 of the US Tariff Act of 1930 is principally used as a border measure for the enforcement of intellectual property rights, by stopping the infringing goods by the customs authorities.⁵⁸ British *Anton Piller* order is a formidable weapon against counterfeiting and piracy. It enables the right holder, in an *ex parte* proceeding, to force the infringer to provide information regarding the supplies of the infringing goods or to allow access to his business records, provided that there is a high probability of infringement and that there are unambiguous indication that the infringer is in possession of incriminating documents or articles whose destruction is anticipated. Its application can go far beyond enforcing there mere revelation of information on the origin of counterfeit goods. French law similarly provides for *saisie contrefaçon* on preservation of evidence.

The countries have also started giving effects to the provisions of TRIPS. For example the new customs seizure provisions, which became effective from July 1, 1995. The Australian Copyright Act have increased border enforcement by Austrainina Customs Authority (ACA) to prevent the unauthorized importantation of copyright materials. In accordance with the TRIPS provision, the new scheme permits a copyright owner to lodge a notice with the ACA objecting to the importation into Australia of any copyright material (including compact discs, music video tapes and computer software). The notice

⁵⁸ On S/337, See David Palmeter, "SI337 and the WTO, Agreements – still in Vilation 20 world competition 27 (1: 1996)

remains in force for a two-year period and for this a security of \$5,000 is to be given to the ACA. Japan has also revised its Copyright Act in accordance with the TRIPS. Many developing and there should countries have also started giving effect to these provisions by amending their existing laws and introducing additional provisions, though most of them already have substantive provisions in their statutes, borrowed from their colonial past. The momentum is starker in Asia, such as the Thailand's new Copyright Act, 1994 (came into effect on March 21, 1995) provides penalties for infringements. It has established an Intellectual Property and International Trade Court and Procedures Thereof (became effective on Oct., 26, 1996), which has jurisdiction over civil and criminal cases involving IPRS, and transfer of technology and has expedited the procedure of settlement of cases. Hong Kong, in May 1996, passed the Intellectual Property (World Trade Organization Amendments) Ordinance, which has introduced the border enforcement measures in the territory. Philippines, Singapore, Indonesia, Vietnam are similarly modifying their laws. China, which is not yet a member of the WTO, has introduced a set of border measures to enforce IPRS, which are effective from October 1, 1995. It has also amended its criminal code (March 1997) and has provided for stringent criminal penalties for IPRS infringements. For selling substandard and dangerous products, even penalty of death sentence has been provided. Specialist tribunals on IPRS at higher courts level

are operating in big commercial cities. The move for strong enforcement of IPRS is, to a great extent, motivated by a strong domestic pressure from Chinese industries, which do not want their inventions and technologies to be stolen.

Enforcement of IPRS in India

After the entry into force of the TRIPS Agreement, India has given effect to its different provisions through amending the existing IP laws or legislating new ones. In this process, it has amended its Copyright Act 1957 (in 1994 and subsequently, in 1999) and the Patents Act, 1970 (by the Patents (Amendment) Act, 2002); replaced the Trade and Merchandise Marks Act 1958 with the new Trade Marks Act 1999; and enacted the Geographical Indications of Goods (Registration and Protection) Act 1999; the Integrated Circuits Layout - Design Act, 2000; and the Plant Varieties and Farmers' Right Act, 2001.

Chapter - IV

Domain Name and Trademark Law

An Overview

With the advent of the internet, the world today is witnessing a revolutionary change in the field of communications. It has brought the whole world at the click of the mouse. Out of nowhere, the internet seems to have exploded on the forefront of several commercial establishments, organizations, governments, and institutions. Every body, who is somebody, seems to have something to do with the internet. The growth of website has also given rise to a new era of disputes - domain names dispute. Flashing an internet address has become a sine qua non for almost every organization.

This chapter has tried to focus on domain name vis a vis trademark law in India, and also such international bodies, which have tried to allay fears if genuine users, and bring them respite. It has also tried to analyse the specific issue whether cyber squatting would amount to a violation of trademark law in India. The growth of websites has also given rise to a new an era of dispute-domain name dispute.

Concept and definition of Trademark

A domain name is known technically as a "uniform resource locator" or "URL". The domain name actually consists of a series of numbers that are used to identify a specific computer connected to the internet. A domain name is an internet equivalent to of a

telephone number or geographical address.¹ The communication format used on the internet is known as the Internet Protocol (IP). As part of the IP, internet addresses are comprised of a string of digits delimited by periods (commonly called dots). In other words a domain name always contains two or more components, separated by periods called 'dots'. The separated or delimited field indicates the network, sub network and the local address read from left to right. A typical Internet address might appear as "11.23.55" where "11" denotes the network, 23 denotes the subnet work and "55" denotes the computer itself. This all numeric form is known as the Internet protocol address. Domain names are nothing but proxies for the IP address, although there is no logical correspondence between the IP address, and the domain name. When computers communicate the Internet, they do not "talk" in terms of domain name, but interpret a domain name into the corresponding Internet Protocol Address. All servers in the internet interpret the same domain names the same way.² That's the reason why when one types of indiainfo.com, one is taken to the web site hosted by indianfo, irrespective of where the person accessing the data is located or which server he is connected to. It is essentially for this reason that domain names are unique, therefore, identical domain names cannot be offered to a two

¹ Ira, Natheson S, showdown at the domain name corral: Property rights and personal jurisdiction over squatters, poachers and others parasites, University of pittsburg law Review, 991 (1997).

² Robert , - internet domain names - whose domain names is this? Service, <http://www.itu.ch/intreg/dns.tml> (quoted sypre)

separate entities. As with Internet Protocol Address domain names are also delimited with period ("dot"), which are read from right to left. This is the domain name "indiainfo.com" indicates as ".com" as the network and Indiainfo as the subnetwork. The domain name at the extreme right is called the "top level Domain" (TLD) and any domain to the left of the TLD and separated by a "." (dot) is the second level domain (SLD). A domain to the left of the SLD is known as the sub domain (SD). The sub domain, second level Domain and the Top level domain put together comprise a "domain name".³ This in the domain name "law indianfo.com" ".com" is the LTD "indianfo" is the SLD and "law" is the SD.

(III) Domain Name Disputes and Trademarks Law

Domain name disputes are relatively unheard of in the Indian Courts. There have been hardly a handful of reported decisions regarding domain name disputes and the case law has still not developed in India. However, with the use of internet catching up at an amazing pace in the country, the Indian Courts would surely be faced with domain name disputes in times to come. A global study of domain name disputes would show that they could broadly be classified under the following head.

³ Supra

(i) Infringement

This refers to the dispute where the original restraint intentionally trades off the resemblance between the domain name and another famous trade mark. Therefore, the registrant tries to cash on the reputation of the trademark holder by running a business similar to that of the trademark holder. In such cases, the use of trademark (domain name) would be illegal under the existing trademark law, regardless of whether, the infringement occurred as a Internet domain names in or any other context.⁴

The standard factors which determine infringement under the traditional trademark law like. (a) the strength of the trademark; (b) the deceptive similarity between the plaintiffs and the defendant's mark; (c) the likelihood of confusion in the minds of public, etc., would apply in cases of infringement of domain names also.⁵

(ii) Concurrent Claims

In this category of domain name disputes, there is more than one legitimate user of domain name. Apparently there is no intention to trademark off a trademarked name and little or no potential for confusion between the products of the conflicting climates. Both parties have a particular trademark of their own or a valid reason to

⁴ Milton Mueller, Trademarks and domain names: property rights and institutional evolution in Cyberspace. http://1stweb.syr.edu/v_muceller/study.html. This is an excellent article on an empirical study of the domain name - trademark interaction which examines the confusions that have led to trademark best challenges to domain name registrations and settlement and decisions that have resulted the said paper based on the study of 121 cases of domain name disputes.

⁵ Supra n1.

the use a particular domain name (for easy both, sunshine. Computers and sunshine dry cleaners would be interested in registering the domain name (Sunshine.com)

(iii) Cyber Squatting

Cyber squatting occurs when domain names bearing a resemblance to famous trademarks, registered by persons hoping to sell the registration to the corresponding trademark holder. Typically, in such cases, persons who have absolutely nothing to do with the name, virtually pirate the name by obtaining a SLD registration with the com TLD of a well known company or brand.⁶ Sometime parties register name expecting auction them of to the highest bidder. This practice has led the emergence of domain name brokers.⁷ Yet another squatters indulge in instable activities eating up all names that are even remotely related to their business to preempt other squatters.⁸ In the case *British Telecommunication v/s one in a million*⁹, the defendants has registered as a domain names, number of well-known trade names, associated with large corporations, including sainsburys.com marks-andspencer.com, and British telecom.com, which they had no connection. They then offered them to the companies associated with each name for an amount, much more than

⁶ Robert L Tucker - information supper, high way Robbery: the tortuous Misure, links, frames, instatages and domain name - volume Virgina Journal of Law and Technology, 6.

⁷ See Josher Quittner, Billions registered, wirmed (Oct. 1994) 50. Quittner has registered Mcdonald.com, Landry.com, etc. see your name here.com

⁸ For example, proctor and bamble has registered over 150 domain name, i.e. diarrhea.com, bad brath.com, laundry.com etc. see your name here.com, A trendy address for a hefty price, Cleveland plain dealer, (Oct. 1996), 6.

⁹ [1999] F.S.R.

they had paid for them. The court of appeal findings for the plaintiff, traced the origin of passing off back to the 16th Century and quoted *AG Spalding and Bros v/s AW Gamage Ltd.*¹⁰ "Nobody has any right to represent his goods as the goods of somebody else. It is also sometime stated in the propositions that no body has right to pass of his goods as the goods of some body else."

Position in U.S.

The U.S. seems to be forerunner as far as domain name litigation is concerned. Domain name disputes have multiplied many fold in the U.S. over the past few years. The US has now passed the United States Anti-cyber squatting Consumer Protection Act (A.C.P.A.) which came into effect from 29 November 1999. The A.C.P.A., also called the Trademark. Cyber Piracy Prevention Act, calls for broad protection of business trademarks. Guilty party can be found liable for statutory damages up to \$300,000 per trademark if the registration of the Uniform Resource Locator (URL) is consider willful.¹¹ The statute contain long list of factors that suggest bad faith on the past of the domain owner and a trademark, owner ability to bring an action, directly against offending domain names. In fact, the list of the factors that suggest bad faith goes well beyond the typical cyber squatting scenario. The ACPA does not center on the fact that a cyber

¹⁰ (1915) 32 PRC273 at 283.

¹¹ Nisll Christopher, Name Grab, April 2000. Net-Smark Business at Wysiyg:/parent win.70/http://www.26605,2453032,00.html?

squatter offered to sell or transfer the domain name to the trademark owner. It also includes factors such as whether a cyber squatter has any intellectual property rights in a domain name whether a cyber squatter has been engaging in a bonafied use of a domain name to offer his own goods and services or whether a cyber squatter intended to divert customers away from a trademark in a way that create the likelihood of confusion among consumers.¹²

On of the first cases in which a US court was called upon to implement *the ACPA was sport's form LLC vs Sportsman market, inc.*¹³

It the above case the facts were as follows:

Sportsman's market, a mail order catalogue company, was engaged in the business of selling products to aviation clientele and had registered trademark "sporty's". A company called omega entered the aviation catalogue business, formed a subsidiary called pilots depot," and registered the domain names "sporty.com". After sportsman's market filed its law-suit, omega launched another subsidiary called sporty's Farm to sell Christmas trees and then sold the "sporty.com" domain to sporty farm.¹⁴

The Court found that the defendant acted with a "bad faith intent profit" from the domain names "sporty.com" not because

¹² Simrod Eric J and Neclerogohn M, Swatting at Cybers Squatters, Feb. 2000 or up side Today-upside counsel at <http://www.upside.com>

¹³ Source.

¹⁴ Ibid.

sporty's attempted to sell the domain name sportsman's market, inc., the other owner of the trademarks "sporty's", but because of other bad faith factors contained in the Act. One fact noted by the court was that neither sporty's Farm nor omega had any Intellectual Property Right in "sporty.com" at the time of that omega registered the domain name. It was also pointed out by the Court that the list of "bad faith" factors were only indicators that may be considered along with other facts. The Court found that the purchase the use of domain name by sporty's farm, generally suspicious in that Omega created a company in a unrelated business that received the name sportys farm only after the law suit was filed.¹⁵

*In Panvision International Vs Toeppen*¹⁶, Toeppen applied for and received registration of the domain name "Panavision.com". He then established a Web site displaying aerial views of the city of pana, Illinois. At no time did Toeppen use the name "panavision.com" in connection with the sale of any goods or services¹⁷ Toeppen's registration effectively prevented the plaintiff, Panavision International, from registering and using its own trademark as it Internet domain name. Toeppen demanded \$13,000/- to discontinue use of the name. Panavision asserted that Toeppen's sole purpose in registering the panavision.com domain name was to extort money

¹⁵ Ibid.

¹⁶ Panavision Vs Toeppen – 938, Spp. 616 (CD Cal 1996).

¹⁷ Id at 619.

from Panavision. Panavision filed a suit in the Federal Court against Toeppen for, inter alia, trademark dilution and trademark infringement, relying on the Federal Trademarks and Dilution Act, 1995 (The said Act provides that owners of famous marks are able to enjoin another's commercial use of that mark even if the mark is used in the non competing market and there is no chance of consumer confusion, if such use first begins after the mark has already become famous and causes dilution of the distinctive quality of the mark. It is also provided that a finding of dilution does not need to be predicated upon a finding of consumer confusion.¹⁸

In the US, the Courts have brought cyber squatter within the preview of the Anti-Dilution. Interestingly, not a single court has upheld the right of a cyber-squatter to profit from poor registration of the domain name. In fact, the Federal Dilution Act does not provide for the transfer of a domain name as the remedy, the American Courts have not merely enjoined the use or sale of domain name by cyber squatter, but have also transferred ownership to the challengers. This is one of the clear example of the way in which trademark rights in cyber space are being expended beyond their normal meaning in law.¹⁹

¹⁸ Michael Tanner – Trademarks, Internet Domain Names and the NIS: How do we fix a system that is already broken? Vol.3, Issue 2, Journal of Technology Law and Policy (1998).

¹⁹ Supra n.4

Position in England

Recent IP disputes have led to the reconsideration of the applicable rules of jurisdiction and justifiably. These actions are needed to apply the Brussels Lugano convention. The scope of application of this convention may be wider in the UK Courts than of those in Europe.

In UK one is a subject to the Civil Jurisdiction and Judgments Act, 1982, and the Private International Amendment Act, 1995, the common law on conflicts of law and the Supreme Court rules of practice. The statutes cited incorporated into UK law the Brussels Lugano convention of 1986, which effects the whole of Europe non convention countries). Non-convention countries are also affected.

In relation to Civil Jurisdiction and Judgments Act, 1982, particular attention should be taken of the 1995 amendments, specifically section 10 and 11. Section 10 abolished the double actionability, rule, which allowed claims only where the tort would be actionable as a tort in the foreign jurisdiction. Section 11 was enacted to clarify the required test for jurisdiction for contract, and other tort and claims. The rules are as follows: for actions in tort, the jurisdiction in place of the tort; for action in contract, the jurisdiction in place where there is the contact; for all other actions, the

jurisdiction is the country with the most significant relationship with the occurrence.²⁰

The court have held that cyber squatting is violative of the rights protected under the trademarks law.

*In marks & Spencer PLC Vs One in a Million*²¹ in the High Court of Justice, chancery Division, enjoined the activities of the two cyber dealers and their related companies, who had obtained and were offering for sale and 'hire', numerous domain names containing well known marks. In this group of cases, the Court enjoined "the threat of passing off" (a threat which would become a reality if in the event a domain name was sold and to used by a stranger to the trademark owner), issuing a warning to cyber squatters.

Any person who deliberately registers a domain name on account of its similarity to the name, brand name or trademark of an unconnected commercial organization must expect to find himself on the receiving end of an injunction to restrain the threat of passing off and the injunction will be in terms which will make the domain name commercially useless to the dealer."

²⁰ Connolly Lain M, Jurisdiction over trademarks and domain names: the view from the Cannock, April 2001. at <http://www.fewf.com>

²¹ FSR 265, 1998, (1997).

As is evident from the above, the courts over the world have generally frowned over cyber squatters and have protected the plaintiffs under the trademark law.

Position in India

Although the above cases seem to have great persuasive value for the Indian judiciary, one has to keep in mind that the above decisions have been passed on the basis of the applicable codified trademark law.

The main issue of contention is the relationship between domain names and trademark. While domain names were originally intended to perform only the function of facilitating connectivity to remember and use. Business have started to realize the significant potential of websites as primary means of E-commerce. By using trade and service marks as their domain names, business hope to attract at their potential customers to their websites and increase their market visibility, ultimately their sale and profits.

With the growth of internet in India, domain names have increasingly come into conflict with trademarks. The possibility of such conflict arises from the lack of connection between the system, for registering trademark, on one hand and the system names, on the other hand. The former system is (trademark) administered by a public (governmental) authority on a territorial (either national or

regional) basis, which gives to rights on the part of the trademark holder that may be exercise within territory. The latter system (domain names) is usually administered by a non-governmental organization (netronics) without any functional limitation, domain names are registered on the first come first serve basis and offer unique, global presence in the internet²², The trade and merchandise marks Act 1958²³ defines trademark also follows:²⁴

Trademark means (i) in relation to chapter²⁵ other than section 81)²⁶ a registered trademark or a mark used in relation to goods for the purpose of indication or so as to indicate a connection in the course of trade between the goods and the some person having a right as proprietor to use the trademark; and (ii) in relation to other provision of this Act, a mark used or proposed to be used in relation to goods for the purpose of indication or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the (.) trademark whether with or without any indication of the identity of that person, and include a certification trademark registered as such under the provision of chap VIII.

²² Source <http://www.see> trademark.com at 0.5.07.2003

²³ As Amendment Act

²⁴ See Section 2(i) (V).

²⁵ Chap X of the Act deals with offence, penalties and procedure

²⁶ Section 81 of the Act Provides for penalty for falsely representing a trademark as registered.

Essentially, trademark are names and symbol that a company uses to identify its goods or services in the market place. Trademarks identify the service of the product and also help indicate the quality of a product or service.²⁷ The trademark law seek to provide effective protection of trademark²⁸ and prevents the use of fraudulent marks on Merchandise.²⁹ Suffice to state that the Act seek to prevent consumer confusion as to the source of particular goods and services by prohibiting a subsequent competing business from using an identical or extremely similar product or symbol a previous competitor.³⁰

Under the Act, a registered trademark is infringed by a person who, not being a registered proprietor of a trademark or a registered owner thereof using by way of permitted use, uses in the course of trade, a mark which is identical with or deceptively similar to the trademark in relation to any goods in respect of which the trademark is registered and in such manner so as to render the use of the mark likely to be taken as being used as a trademark.³¹ Unregistered owners of trademarks are also entitled to protection of their marks under the scheme of the Act. Therefore, in order to prevail in a trademark infringement claim, the claimant must show that:

²⁷ Tanner Miched, Trademarks, Internet domain names and the NSI: how do we fix a system that is already broken? *Journal of Technology Law and Policy* 3(2) 1998.

²⁸ Statement of Object and reason to the Act.

²⁹ Preamble of the Act.

³⁰ S/11 of the Act provides for the prohibition of registration of certain marks and S/12 (i) of the Act prohibits registration of identical or deceptively similar trademarks.

³¹ S/29 of the Act.

1. The marks is protectable under the provision of the trade and merchandise marks act;
2. The defendant in using the same or similar mark;
3. The defendant is likely and cause consumer confusion regarding the origin of the goods.

Although the first two issues are necessary for finding an infringement, the central question in any infringement case which whether there is a substantial likelihood of consumer confusion due to the similarity between the marks.

The Role of Judiciary on Domain Name Passing off

Passing off on the internet litigation is not very common in India. The first reported Indian case was *yahoo/in/ vs Akash Arora*.³² The former, the global internet media search and information network, filed an action against the latter on the internet as those of the plaintiffs by adopting the domain name yahooindia.com. *Titan Industries vs Prashant Koorapti & other*³³ the defendant the registered the domain names "tanishiq.com". The plaintiff company which has been using the trademark "tanshique" with respect to watches manufactured by it, used for passing off and alleged that the use of the domain name by the defendants would lead to the confusion and deception and damage the good will and reputation of the plaintiff.

³² AIR 2000, Bom.

³³ Source: <http://www.iptoday.com>

The Delhi High Court has granted an ex parte interim injunction restraining the defendants from using the name 'TANISHIQ' on the internet or otherwise and from committing any other act as is likely to lead to passing of the business and goods of the defendants as the business and goods of the plaintiff.³⁴ The Court relied upon the decision in *Parkerknoll v/s Knoll International*³⁵ where the House of Lords had held that where the object is to deceive the court will be very much more ready to interfere in that its object has been achieved. Moreover, in the "rediff" case the court relied on the fact that the both plaintiff and defendant had a common field of activity; both operated on the net and provided information of a similar nature, both offered the facility of sale of books, etc. both offered to chat line and a cricket opinion poll.

The court further held that there is every possibility of the internet user getting confused and deceived in believing that both domain names belong to one common source and connection although the two belong to the different persons. The court was satisfied that the defendant have adopted the domain name. "Radiff" with intention to trade on the plaintiff reputation and accordingly the defendant was prohibited from using said domain name.³⁶

³⁴ Ibid.

³⁵ [1962] PRPC 265 (HL); per Lord Devlin

³⁶ Supra no.2.

Global Scope

The UDRP is international in scope, it provides a single mechanism for resolving a domain name dispute regardless of where the registrar, the domain name registrant, or the complaining trademark owner is located. Any person or company in the world can file a request for the resolution of a domain name dispute through the UDRP procedure, asserting that each of the UDRP criteria is presenting its case. UDRP proceedings administered by the WIPO Center has involved parties from over 100 countries across the world.

Some of the advantage of WIPO Arbitration and Mediation Center over ordinary litigation are:

I. Time and Cost Effective

Compared to court litigation, the UDRP procedure is highly time and cost effective, especially in an international context. A domain name case filed with the WIPO Center is normally concluded within two months, involving one round of limited pleadings and using mostly online procedures. WIPO fees are fixed and moderate.

II. Enforceable Decisions

A key advantage of the UDRP procedure is the mandatory implementation of the resulting decisions. There are no international enforcement issues, as registrars are obliged to take the necessary

steps to enforce any UDRP transfer decisions, subject to the losing party's right to file court proceedings and suspend the implementation of the decision.

III. Transparent

The UDRP process is transparent. The WIPO Center posts all disputed domain names, case status, case statistics and full text of decisions on its web site. In addition, the WIPO Center's online Index of WIPO UDRP Panel Decisions offers easy access to the jurisprudence developed under the UDRP.

IV. Without Prejudice to Court Adjudication

Once a complainant initiates UDRP proceeding, the registrant of a domain name must submit to the process. However, in line with its administrative character, the UDRP does not preclude the domain name registrant or the trademark holder from submitting the dispute to a court for independent resolution; either party may commence a lawsuit in court before, during, or after a UDRP proceeding. Paragraph 4(k) of the UDRP also allows a losing domain name registrant to challenge the administrative panel's decision by filing a lawsuit in a competent court and thereby suspend the implementation of the panel decision. Although parties retain this court option, in practice this is a rare occurrence. The WIPO Center maintains a selection of

court order and decisions in relation to the UDRP or specific UDRP cases at its web site.

The Three UDRP Criteria

The UDRP procedure is designed for domain name disputes that meet the following cumulative criteria (UDRP, paragraph 4(a)); (i) the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the domain name registrant has no right or legitimate interest in respect of the domain name in question; and (iii) the domain name has been registered and is being used in bad faith.

Relief's Given by WIPO

Disputes under the UDRP are decided by independent panels appointed by the WIPO Center. The remedies available to a complainant in a YUDRP proceeding are limited to the transfer of the disputed domain name registration to the complainant, or the rarely requested option of cancellation of the domain name registration. Neither monetary nor injunctive relief is available. Panels decide on the basis of the submitted complaint and response, without oral hearing. If a panel registration should be cancelled or transferred to the complainant, the concerned registrar will normally implement the decision after ten business days. If the complaint is denied, the

registrar will unlock the domain name for the benefit of the respondent.

The first case which was decided by the body was *World Wrestling Federation Entertainment, Inc v Michale Bosman*,³⁷ where in the respondent had registered the domain name of the complainant only to sell them at US \$1,000,000. The administrative panel ordered the respondent to transfer the ownership of the domain name to the complainant. Subsequently the panel has also decided a plethora of other disputes, which include a number of Indian companies as well.³⁸

³⁷ Case Number D 99510001

³⁸ The first Indian Case before the administrative panel was Bennett Coleman and Dcom limited V/s Steven's Lalwani, Case number D2000, 0014; Source.

Chapter - V

Judicial Response

Judiciary happens to be one of the most important organs in any modern democratic countries. It is not only interpreter of law but also the guardian of rights of the people.

Judiciary has been playing the vital role for the important reflection in the field of trademark adverse affect of the intellectual property protection, particularly the trademark, on trade and business etc. It is established fact that judiciary is the third organ of the government in any democratic country. It is the final protector and interpreter fundamental rights of the people. The law relating to trademark is not very common in India. So the litigation relating to internet is not very common in India. The first reported Indian case was *yahoo! Inc v/s Akash Arora*¹, where the plaintiff who is the registered owner of the domain name "yahoo.com" succeeded in obtaining an interim order restraining the defendants and agents from dealing in service or goods on the internet or otherwise domain name "yahooindia.com" or any other trademark/domain name which is similar to the plaintiff trademark "yahoo."

The plaintiff submitted that their domain name "yahoo.com" was registered with network solutions Inc (NIS) since 1995, that it had become well known and they had obtained registration of the trademark "yahoo" or variation thereof in approximately 69 countries

¹ 1999 PTC 1920 (Del)

although not in India. The defendants registered the domain name "yahooindia.com" with NSI in November 1977, as well as 16 variations containing the word "yahoo". The plaintiff objected to the defendant's use of the domain name and the defendants responded modifying the announcement of their forthcoming website and by including the disclaimer that www.yahooindia.com had no connection with "yahoo", Inc of California, USA. The defendants thereof activated their website and adopted substantial part of plaintiff's Singapore website named "yahoo.com" which contained in India.

The defendants submitted that a website, unlike a trademark, is a specific address and that their disclaimer would eliminate any confusion. They further pointed out that there was no protection for series in India that no goods - were involved in this case. In addition they claimed that, contrary to the plaintiff, that we offered only content specifically directed to India, that "yahoo" was an English dictionary word available and that Internet users, who are usually sophisticated would to known the difference between the two websites.

The Delhi High Court rejected the defendant arguments on the ground, "interalia", the trademark law applies equally to domain names on the Internet, that, where the parties are in the same or a similar line business, the use of similar names would result in

confusion and deception; that the disclaimer by the defendants on their website did not reduce the likelihood of the confusion, that the plaintiff had obtained registration on the trademark yahoo and variation thereof in 69 countries; that the mark was widely publicized to and well known and that the fact that "yahoo" was a dictionary word was no reason to deny protection for the trademark. The mere fact that the internet users were technically educated and literate, this would not reduce the risk of confusion. The Court held that: in an internet service, a particular internet site could be reached by anyone anywhere in the world who proposes to visit the said Internet site. With the advancement and progress in technology, service rendered on the internet has come to be recognized and accepted and are being given protection so as to protect such providers of service from passing off the service rendered by other as that of the plaintiff. As a matter of fact in a matter where services rendered through the domain name in the Internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globalization.

This was the first case in India in which the court has applied trademark law to support a judgment in a domain name dispute. This decision is particularly significant as the Indian trade and merchandise marks Act 1958 does not provide for registration of

service marks and the court in effect extended the principles common law to cover service offered through the Internet.²

Similarly Mumbai High Court in Rediff communication Ltd v/s Cyberbooth³ had faced a case where the defendant has adopted the domain name 'www.radiff.com" despite the existence of a well known website of the plaintiffs www.radiff.com. The court found that such an adoption by the defendant was completely dishonest and held that once the intention to deceive is established the court would not make any further enquiry whether there is any likelihood of the confusion or not. In *Sony Corporation vs Park Kwangsoo*⁴

The domain name NEWS SONY.COM is identical and confusingly similar to the domain and as the goodwill of the complainant who is one of the worlds premier entertainment electronic companies, would be tarnished by the showing of sexually explicate and pornographic material put on the website which is the only user under the impugned domain name, the said name should be transferred to the complaint sony.com. In another important case *Acqua Minerals Ltds. Vs Promod Borse & Another*⁵ where the plaintiff was the registered proprietor of a trademark 'Bisleri' which was also registered under the Trade & Merchandise Marks Act. The said Trade Mark was extremely well

² Source: <http://www.ladas.com> as on 05/17.2003.

³ AIR 2000 Mumbai. 27.
2001.

⁴ PTC 492 (WIPO)

⁵ 2001.

known in the Indian Markets in respect of bottled mineral water. Bisleri was distributed over 500 towns and cities and had a market share of 70% in respect of bottled mineral water segment.

The plaintiff applied to M/s Network Solutions Inc (NSI) of U.S.A. (this was the registering authority for registration of domain names_ for registration of its domain name as 'bisleri.com'. However, NSI informed that the said domain name had already been registered by the defendant. The defendant had demanded huge sums of money by means of a letter from the plaintiff for the transfer of the domain name 'bisleri.com' Incidentally the defendant had already its own domain name 'infor@cyberworld.com. The defendant had no valid justification for usage of the term 'bisleri' in its domain name.

The Delhi High Court held that the defendant had acted malafide and had registered the domain name in bad faith in terms 'If the rules of the registering authority since they wanted to see unjust enrichment and thrive upon the goodwill of the plaintiff. The defendant had infringed the trade mark of the plaintiff and was also accountable for passing off, the Court restrained the defendant from using the said domain name since it was bound to create confusion when a person intended to know about the product of the plaintiff. A potential customer was likely to go to the website and type 'bisleri.com' which would infact take him to the site of the defendant. The High Court also observed that the defendant has obtained the

registration of the domain name in bad faith as was evidenced by his demand for money from the Plaintiff.

In above the cases of Rediff Communications, Sonny corporation and the Acqua minerals, the High Courts have clearly held that domain names enjoyed the same sanctity as trademarks. Further, in *Bhagwatlal Chamanlal vs Shulton Inc and other*⁶ where the appellant made an application to register a trademark consisting of the word *OLDSPICE* in respect of safety razor. The said application was advertised in the trademark journal on 16 July, 1993. The respondent lodged a notice of opposition to the registration on the grounds that the impugned trademark is deceptively similar to its trademark. In summary, the respondent submitted that the mark offends the provisions of sections 9, 11(a), 11(e) and 12 of the Act. Appellant filed counter statements on 20.4.74 denying all the allegations contained in the notice of opposition of the respondent.

The court held that the goods in the matter of safety razors, shaving brush namely, after shaving lotion, collogue, for men, body talc brilliantine and shaving cream, for which respondent is holding registration in India are the goods carried in the same kit by the user, made available by the hotels to its guests in the same bathroom and sold in retail from the same sales outlets. This is enough to indicate that they belong to the same family, same description and to the

⁶ 2005 (3) PTC 88.

same class of goods, irrespective of the razors or hair brushes. Further court observe that there is nothing to conclude deceive or cause confusion for the purpose of section 11 (a) of the Act. Respondent are registered proprietor of mark "*OLDSPICE*". The goods cover under those registration are being manufactured and marketed in India. The similar issue was raised before the Bombay and Delhi High Courts in *Centurian Industrial Alliance vs Gillette liLtd*⁷ and *Dhirlpool & Company and Another vs/ N.R. dongre*.⁸ The learned Assistant registrar in TA/290 has correctly arrived at the conclusion that since the products involved are in the same description, the impugned mark is likely to be cause confusion and description and correctly disallowed are registration of the mark.

Lord Raid expressed similar view in his judgment. He observed that:

"The same description does not mean that you work for a description which applies to both goods, but rather indicates a similarity in various aspects, there being no single conclusive test."⁹

From the elaborate observation of this case, the following main inferences can be drawn.

It is enough to indicate that all the goods, belong to the same family, same description and same class of good, irrespective of the fact that whether there are creams, razors or hair brusher.

⁷ 1998 PTC 288 (Bombay)

⁸ 1996PTC 415 (Delhi)

⁹ *Daiquin Rum* TM1969, RPC 600 HL

This is enough to place that in the same description of goods for the purpose of section 12(1) of the Act,¹⁰ there is nothing conclude that the impugned marks are not likely to deceive or cause confusion to for the purpose of section 11 (a).¹¹ The goods covered under those registrations are being manufacture and marketed in India. In another important case in another important case, *Bata India Ltd. vs/ Deputy registrar of Trademarks and Others*¹² where

The appellants who was the registered proprietors engaged in the business of manufactory and marketing footwear, made of rubber, leather and other materials. He registered trademark "BSC". The impugned mark seeking registration is identical with and deceptively similar to the appellants registered trademark BSC. BSC stands for *Bata Shoes Company*. The registration of trademark applied for is contrary to the provision of section of 11 (a), 11 (e), 12 (1) and of the trade and Merchandise Mark Act 1958.

Respondent adopted 'BSC' at their mark since 1975 and their bills and invoices evidencing use of such device and letter marks since 1978. They built up goodwill and reputation of the mark in respect of their products and use of said mark "Bata" as also 'BSC' as combined mark, that two only in respect of footwear, it is not open for their to claim user of the trademark "BSC" separately. Moreover, the appellant is using the mark "BSC" along with "Bata". Appellant never

¹⁰ Trade and Merchandise Marks Act 1958

¹¹ Trade and Merchandise Marks Act 1958

¹² 2004(29) PTC468 (IPAB)

used either or "Bata" or "BSC" separately in any of the advertisement. When appellant is using the mark "BSC" along with "Bata, then both should be taken together and each one cannot be separated. When there is no possibility of any confusion so, far as the goods are concern, the impugned order of the Deputy Registrar need not be interfered with.

The Court held that most of the advertisements of the appellant contains both marks "Bata" and "BSC" in respect of shoes individually.

The Court further observed that the word "Bata" also stand for Bata Company. When that be so, it is not clear to how the sales statistics can represent only the "BSC" mark. Even it is so it can only in respect of shoes and footwear.

However, that case the appellant must have filed separate sales statistics in respect of the mark "Bata" as well as "BSC" as a combined mark and only in respect of footwear, now it is not open him to claim that he using the trademark "BSC" separately, especially in the absent of any evidence to establish the same the two isolated advertisement pamphlets cannot be conclusively taken the BSC mark is being used by the appellant as an independent mark without the work mark "Bata."

In *Honda Motor Company V/s Lokita Enterprises*¹³ the Court observed that the plaintiff obtained in 1948, incorporated with the

¹³ 2004 (28) PTC 332

name Honda as the key and principal feature of its business name also as its trademark since its incorporation. The complainant gave its business an international dimension and started exporting its motorcycles under the trademark "Honda" to the United States of America in 1959. The complainant is one of the twelve largest producers of automobiles in the world. The products of the complainant are sold in more than 160 countries. The name mark, Honda, of the complainant is registered as a trademark *inter alia*, in the following countries. Afghanistan, Albania, Algeria, Argentina, Armenia, Aruba, Australia, Benelux, India, Libya, Iraq, Ireland, U.S.A. In India the trademark of the plaintiff is registered under the registration number 201233 in class 12, 225,243 in class 07, 422,777 in class 07 and 39,380,3 in class 12.

Plaintiff hosts and maintains a large number of websites throughout the world, with domain names consisting "Honda" in connection (combination) with various business related geographic suffix, including the domain name "Honda Car India.com"

Respondent has registered the domain name < hondaindia.com >

The domain name is identical to the trademark of the complainant. The plaintiff presented that the word "HONDA" is an essential part of the domain name "Honda India.com" of the defendant. (Respondent). The said domain name is intended to project a message

to the surfer/consumer the respondent is the subsidiary an associated company of the plaintiff's in India.

The respondent has no rights or legitimate interests in respect of the domain name. It means that respondent has no trademark right, or legitimate rights in respect of the domain name one to the complainant's long prior use of its mark. Honda is not a legal name of the respondent.

The domain name was registered and is being used in bad faith. The fact that the respondent has chosen not to do so implied malafide intentions on its behalf to the sell to name of the third portion. The respondent has not established a website accessible via domain name "hondaindia.com". The respondent first registered the domain name in October 1999. If the respondent had a bonafied reason to register they said domain name, it would base proceeded to activate the website at the said domain name address. The respondent appears to have made false representations to the registrar that his registration of domain name will not infringe or violate the trademark rights of third party.

If the respondent or any third party were to activate a website via the said domain name, this would create confusion among internet who would be misled into believing that there is some connection between the website and complainant. It is submitted that the

respondent is preventing the complainant from making legitimate use of its trademark on the Internet.

Respondent is planning to go back to India permanently in the year 2005, and start a non profit charity organization with the sole purpose of helping the poor and neglected kids who are the future citizens of India by providing them food, shelter and good education response and also plans to extend the charity work for helping battered women, helping the poor neglected senior citizens, open hospital to the poor people.

According to the Respondent the word HONDA in the domain name "HondaIndia" stands for:

H = Humble

O = Organisations for helping

N = Neglected kids

D = Develop their

A = Ability

Respondent has asserted that his registration of the contested domain name took place before the Uniform Domain Name Dispute Resolution policy was approved by the Internet Corporation for Assigned Name and Numbers.

Previous decisions under the UDRP have decided that through the renewal of the registrar com has, through its registrar verification, also confined that the UDRP applies.

The addition of the name of a geographical suffix to a trademark such as addition to India to "HONDIA", is common way of indicating subdivisions of global enterprises or the geographical area that that the goods are offered under a trademark. The court held that the name of geographical suffix to a trademark, such as the addition of India to "HONDA" is common way of indicating subdivision of global enterprises or the geographical area that goods are offered under a trademark. Complainant itself has evidence that it uses the domain name "Honda cars India.com" in connection with the offering the goods and services in India.

The complainant's trademark is famous around the world (globe). The addition a suffix, therefore, does not sufficiently alter the underlying mark to which it is added. A user of the internet is, in the penal, opinion, likely assume that complainant is the sponsor of, or is associated with, the website identified by disputed by technical factors and customary practice among domain name registrations, and without legal significance from the standpoint of comparing complainant's trademark and contested domain name. Hence, the complainant has met its burden of proving that the domain name of

issue is confusingly similar to complainant's trademark pursuant of the policy, therefore, the respondent has no rights or legitimate interests in the domain name issue.

Respondent has furnished no evidence of use of the domain name at issue. Respondent has asserted an internet to establish a non profit charity organization paragraph 4(c) of the policy does not contemplate the attribution of rights based on the abbreviation of name of a hypothetical future non profit charity organization.

Respondent has not used the name in connection with a bonafied of goods or services has not been commonly known by the domain name nor is it making legitimate noncommercial or fair use of the name. According to the UDRP this does not however, necessarily prevent that the domain name has been registered and used in bad faith. In *Dabour India Limited V/s Colgate Palmolive India Ltd.*¹⁴ where the was the plaintiff has the largest share of 80 percent of the Ayurvedic tooth powder market (excluding white tooth powders) of this product country wide. It has turnover of about K150 crores for *Lal Dant Manjan* tooth powder and its advertising budget for the said product is 4 crores. In any event the defendant's advertisement affects the plaintiff the most and the hence it is entitled to ventilate its grievances. While the advertisement does not directly refer to Dabur Dant Manjan. The plaintiff product, is impugned visual

¹⁴ 2004(29) PTC 401 (Delhi)

advertisement featuring a popular cine star runs down all *Lal Dant Manjan* tooth powders as surely to dental health and in particular damage email. Through the offending advertisement not directly referring to the Dabar Lal Dant Mangan Powder, the plaintiff's product plaintiff entitled to complain it being on of the largest producer of such powder. In order to describe its product, the defendant cannot describe as inferior and damaging the generic product *Lal Dant Manjan*. The Court held that the advertisement campaign on the visual media has an immediate impact on the viewers and possible purchasers minds particularly when a well known cinestar is endorsing it. The plaintiff has thus made out prima-facie case of comparative strength particularly when the defendant does not deny that it campaign points out the deleterious effect of *Lal Dant Manjan* powder. The balance of convenience is also in the favour of the plaintiff as the effect of the advertisement aired cannot be repaired readily and easily. The averred right of the defendant to inform the purchasing public of the ill effects of the *Lal Dant Manjan* powder based on its commissioned study cannot tilt the balance of convenience in the favour of the defendant particularly when the plaintiff also seeks to rely upon studies commissioned by it to back up the merits of its product. Consequently, the non-grant of an interim injunction would cause irreparable injury to the plaintiff which is not compensable in damages.

Consequently, the plaintiff is entitled to an injunction and accordingly the defendants are restrained from telecasting the TV commercial "Colgate Tooth Powder" as depicted in Annexure 'A' to the plaint.

The court further observed that whether the *Lal Dant Manjan* referred to in the advertisement is that of the plaintiff, the plaintiff is certainly entitled to as it one of the largest product of such tooth powder. Further court held that in order to praise its product it can describe as inferior and damaging the generic product *Lal Dant Manjan* is not acceptable. Slandering of a rival product as a bad not permissible. Similarly in *Eastood V/s Homes, Willes, J.* observed that "The action cannot be maintained. Assuming the article to be libelous, it is not a libel on the plaintiff; it only reflects on a class of persons dealing in such objects; and it is immaterial in this view whether they are genuine or not. If a man wrote that all lawyers were thieves, no particular lawyer could sue him unless there is something to point to the particular individuals, which [350] there is not there. There is nothing to show that the article was inserted with any special reference to the plaintiff. It does not appear that the defendant knew of his existence.

But further, I am of opining that this is no libel, for that it is protected by the privilege of fair discussion on a matter of public

interest, it is not appearing that it was malicious.” Similarly *In Bestobell Paints Limited v. GIGG*, where court observed:

“refusing the injunction, (1) in the interests of freedom of speech, the courts will not restrain the publication of a defamatory statement, whether a trade libel or a personal one, where the defendant says he is going to justify it at the trial of the action, except in cases where the statement is obviously untruthful and libellous.”

Again the observation of single learned Judge in *Reckitt & Colman of India Ltd. V Kiwi T.T. K Ltd.*¹⁵ “to contend that once identity of the plaintiff’s goods were not to be traced, then no complaint could be made by the plaintiff and an injunction could not be granted.” In *Reckitt & Colman of India Ltd. V. M.P. Ramachandran & Anr.*¹⁶ a judgment of the learned Single Judge of this Court, are of similar view.

“Therefore, in a suit of this nature one has to look at whether the advertisement merely puffed the product of the advertiser or in the garb of doing the same directly or indirectly contended that the product of the other trader is inferior. There cannot be any dispute that in the concerned advertisements blue was stated to be of inferior quality. Although, for having depicted the container and the price in

¹⁵ 1996 TTC (16) 39.

¹⁶ 1999 PTC (19)741.

the advertisement together it is difficult to proceed on the advertisement insinuations are not made against Robin Blue and the same were directed to all blues as has been stated in no in certain terms in the affidavits, cant it be said that it was not made against Robin Blue. The answer is a definite 'no', because Robin Blue is also blue." Further, the Single Judge of this court in *Dabur India v. Emami Limited*¹⁷ has also been relied upon. The following passages are relevant

"In my considered opinion, even if there be no direct reference to the product of the Plaintiff and only a reference is made to the entire class of Chayawanprash in its generic sense, even in those circumstances disparagement is possible. There is insinuation against user of Chayawanprash during the summer months, in the advertisement in question, for Dabur Chayawanprash is also a Chayawanprash as against which disparagement is made. To the same effect is the judgment of Calcutta High Court in *Reckitt & Colman of India Limited v. M.P. Ramachandaran & Another.*"¹⁸ Further, Court observed that:

"In my considered opinion, when the Defendant is propagating in the advertisement that there should be no consumption of Chayawanprash during the summer months, it is also propagating that

¹⁷ IA No-2124/2004 IN (OS) No- 433/2004.

¹⁸ 1999 PTC (19) 741.

the Plaintiffs' Chayawanprash should not also be taken during the summer months as it is not good for health and instead Amritprash which is the Defendant's product, should be taken. Such as advertisement is clearly disparaging to the product of the Plaintiff as there is an element of insinuation present in the said advertisement."

Again the similar issue raised before the Court in *Pepsi Co. Inc. and Ors. V. Hindustan Coca Cola Ltd. And Anr.*¹⁹ The court observed:

"After analyzing the submissions made by the counsel for the parties which emerges can be summed up thus: it is now a settled law that mere puffing of goods is not actionable. Tradesman can say his goods are best or better. But by comparison the tradesman cannot slander nor defame the goods of the competitor nor can call it bad or inferior.

By calling the Coca drink of the appellants "***Yeh Bachhon Wali Hai, Bachon Ko Yean Pasand Aayeig***", "***Wrong Choice Baby***", the respondents depicted the commercial in a derogatory and mocking manner. It can't be called puffing up. Repeatedly telecasting this commercial will leave an impression on the mind of the viewers that product of the appellant i.e. "PEPSI" is simply a sweet thing not meant for grown up or growing children. If they choose PEPSI, it would be a wrong choice. The message is that kids who want to grow should

¹⁹ 2003(27) PTC 305 (Delhi) (DB).

not drink "PEPSI". They should grow up with "Thums Up". The manner in which this message is conveyed does show disparagement of the appellant's product."

In *Wander Ltd. and another v. Antox India P. Ltd.*,²⁰ the court pointed out that: an infringement action is available where there is violation of specific product right acquired under and recognized by the statute. In a passing off action, however, the plaintiff's right is independent of such a statutory right to a trademark and is against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing-off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deceptions, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or business. The tort of passing-off involves in misrepresentation made by a trader to his prospective customs calculated to injure, as a reasonably foreseeable consequence, the business or goodwill of another which actually or probably, causes damages to the business or good of the other trader. Speaking of the legal clarification of this form of action, Lord Diplock J. expressed similar views in his separate judgment as follows:

"Unfair trading as a wrong actionable at the suit of other traders who thereby suffer loss of business or goodwill may take a

²⁰ 1970 Supp. SCC 727.

variety of forms, to some of which separate labels have become attached in English law. Conspiracy to injure a person in his trade or business in one, slander of goods another, but most protean is that which is generally and nowadays, perhaps misleadingly, described as "passing-off". The form that unfair trading takes will alter with the ways in which trade is carried on and business reputation and goodwill acquired. Emerson's maker of the better mousetrap if secluded in his house built in the woods would today be unlikely to find a path beaten to his door in the absence of a costly advertising campaign to acquaint the public with the excellence of his wares." In *Kalyanapuri Flour Mills (P) Ltd. V/s Tirupati Rollen Flour Mills*,²¹ where the appellant appealed against the order of the registrar of trade mark rejecting their objections for the for the registration of the respondents trademark "Appu" brand and the device of an elephant in respect of wheat products in maida, raw, sujeer, in class 30.

The respondents filed an application in form of TM 1 on April, 1987 under the number of 476144 for the registration of trademark "Appu" of brand and device of an elephant in respect of wheat products. The mark was order to advertise of before the trade mark journal dated 16.11.1992. The appellant filed their objection on 12% 1993. Stating that they are the proprietor of the trademark "Appu" brand in respect of Maida, Sooji and Atta, in class 30 and have applied

²¹ 2004 (28) PTC 332.

for registration of their trademark on 16.1.1992 and same is pending with registry and that they have been continuously and extensively using the aforesaid "Appu" when the both the trademark identical adducing evidence to prove confusion and deception unnecessary - Appellant established their reputation in respect of their mark - even though respondent adopted the name Asian Game. The court held that: when the trademark used by the both the parties are identical, the question of producing any evidence to substantiate confusion and deception in the minds of the purchasers is absolutely unnecessary.

In *Jacques Jaunet S.A. V/s Newonan and Another*,²² where the appellant filed an application for the registration of the trademark "NEWMAN" in class 23 of the trade and merchandise marks Act, 1958. The mark was advertised as proposed to be used in trademark journal on 1st Dec. 1987. The first respondent filed his opposition No. DEL 4901 ON 12.1.1988, stating that they have already filed two applications for registration of similar mark in class 25 of the Act and they are continuously and extensively using the trademark. The further objection was with regard to the violation of Section 9, 11(a), 11(e) and 18 of the said Act.

The registrar of the trademark elaborately discussed all the issues raised by the parties and ultimately by the order dated 26.1.1993 allowed the opposition of the first respondent and refused

²² 2004(29) PTC 747 (IPAB).

registration of the trademark of the appellant. The appellant has been filed a suit against the said design in the Delhi High Court which transferred to this Board by virtue of Section 100 of the trademarks Act 1999. The court held that the rights of the parties are governed by the compromise decree of the Delhi High Court in suit No. 2784/1987 and as such, it is not open to either of the parties to raise any objection against the other unless the logo mark or the trademark sought for the registration by any of the parties contrary to the terms of the said compromised decree.

*Again in Cadila Laboratories Ltd. V/s Khandelwal Laboratories Ltd and Another,*²³ where the appellant filed an application for registration of trademark 'ASTLER' (words per se) as application in class 5 in respect of pharmaceutical and medical preparations in part A of the register on 23.03.1988. The mark proposed to be used. The respondent filed an opposition appeal on 27.7.1992. They submitted that they are the subsequent proprietors of registered trademark 'ASTA' on 28.1.1954. They submitted that the said registration has been renewed from time to time till date. The impugned mark is deceptively similar to their mark. They challenged the impugned mark on the ground of section 9, 11, 12 (1) and 18 of the trade and merchandise marks Act 1958. The appellants filed their counter statement on 13.1.1993, denying all the material grounds relied upon

²³ 2004 (29) 749 (IPAB).

by the opponents. The question is to examine as whether the mark 'ASTLER' so nearly resemble the registered trademark 'ASTA' as to be likely to deceive or cause confusion. The Assistant Registrar relied upon some more English cases and reached the conclusion that the mark are deceptively similar to each other. The appeal against the decision of the Assistant Registrar was taken up by the Board in the sitting held at Ahmadabad on 27th July 2004. The court held that the word "ASTA" has two consonants in it and the impugned word 'ASTLER' has as many as four consonants in it, viz. 'S, T, L' and R. The first vowel "A" in both word in common. However, the impugned word 'ASTLER' has additional letter "E" as a link between "L" and "R". The first vowel "A" in both words though being the same letter of English language gives a different sound in the two words when written in the a Indian Language. At least in Hindi, it shall gives the sound of 'AA' and 'AE' in ASTLER and shall also be written accordingly. These distinctions as described above make much difference between the words - phonetically and visually. In view of this, the word 'ASTER' is distinctive and does not cause any confusion deception in terms of section 11 of the Act it accordingly meets the requirements of section 12(1) also. Consequently the impugned order of the registrar of trademarks cannot be sustained.

It is submitted that the legal precedents where by relief has been provided by the Indian Courts to the owner of registered

trademark against cybersquatter on the ground of passing off and also the grey areas and the deficiencies in the rules of administration penal where is empowered to rectify domain number.

Thus, on the basis of the observations made in its earlier decisions viz. yahoo.ink, rediff communication and equal morals, the court have clearly held that domain name enjoyed the some sancity as trademarks.

However, the most sensible and appreciable part of the judgement in Dabur *Lal Dant Manzan* and it clear that where the registered trademark has got to the reputation and good will, such trademark cannot be permitted to used by other person, as the same would course confusion in the mind of general public that the goods being manufacture with the identified trademark has some connection with the registered proprietor of that trademark. However, the advertisement does not identify and refer to the plaintiff product. The defendant justify such criticism as it is based on studies conducted in the U.S.A. which such *Lal Dant Manjan* Tooth powder to damage tooth enamel. It appears to clarify any ambiguity which may have existed as the applicability of this doctrine to both registered and unregistered trademarks. Therefore, the owner of an unregistered trademark may prevail in a passing off action in so far as it can demonstrate it is only primarily functional therefore valid under the trademark Act.

Chapter - VI

Conclusion & Suggestions

A persual of above discussion leads us to the conclusion that for the last two decades the two important international treaties such as Convention on Biological Diversity (CBD) and the agreement on Trade Related Intellectual Property Rights (TRIPS), 1993 as part of the WTO and are in force. All member of the CBD and TRIPS agreement FACE an inescapative problems of complain with them in letter and spirit. These two important tries are legally binding but their obligation are very from country to country. It is likely that a country in good faith seeks to implement community rights and does so through a CBD framed policy, could find itself in series of contravention of the TRIPS agreement. These international treaties play important role to protect the intellectual property rights copy right trademark, patents designs, geographical indication layout design (topographics) of the integrated protection of the undisclosed information. There are various developed countries and particularly MIVCs, perceive that biodiversity convention will only be functional in a beneficial way for all contracting parties will exist in biological and gentetic material throughout the world.

There are many developing countries like India, Pakistan who are the main holder of the genetic resources, on the other hand, would like to be adequately rewarded for giving access to genetic and

biological resources. Any new system needs to take into account the concerns of developed and biologically rich countries.

It is also necessary that biological rich country should put in place a system which should provide a harmonious construction to their obligation under the TRIPS and CBD. It is important to note that these countries are under obligation to provide access to their biological resources. While developed countries must transfer the technology in prospecting these resources. Benefit sharing mechanism must be properly devised, which should reward the conserves of genetic resources and must allay the fears of technology holders for properly return for their R&D affords.

In order to protect the biodiversity, in the same time governments of biodiversity rich countries, in their zeal to have access to new technology, should not ignore the land races and farmer should be encouraged and obliged to protect them making it mandatory to grow land races in specific portion of their land.

Protection of intellectual property rights will definitely promote the development of new products and services and that erosion of these rights can threaten the economic performance of the information sector and curtail the major benefit. It has brought the abundance of information and the each with the can be accessed, reproduced, and distributed have come problems that must be seen in

all of their complexity as well as the accompanying at policy challenging. Now we can say that IPR are increasing becoming the as compared to the physical assets intellectual property will surely survive. The digital age, though substantial time and effort may be required to achieve a workable balance between private rights and public interest in information. The technological changes bring challenges to the basic principles of IP laws and internet and the digital revolution poses complex problems for IP law and their protection. The three technological advances namely digitization of information, networking, and www. (world wide web) have turned the classical economics of the information upside down. An indication of the relative importance and complexity of the issues involved can be taken from a recent world intellectual property organization (WIPO) estimate that no less than 90% of total investment in a multimedia product was expended in dealing with intellectual property issue.

Intellectual property law are being continuously amended to take care of the technological changes. But it still requires major amendments to deal with challenged posed by the internet and digital revolutions. This allows transactions signed electronically to be enforceable in a court of law. The Act provides legal framework for e-commerce, e-security and e-governance in India.

The various problems posed by digital medium are distribution, catching, protecting of confidential information patent, copyrights, trademarks, domain names, liability for defamatory statements over network, content liability and protection, payment mechanism for internet commerce, money laundering, taxation, issue prohibited and activities etc. I.P. Laws are being continuously amended to take care of technology changes, but still requires major amendments to deal with challenges posed by the internet and digital revolution.

Further, sections 91, 92, 93 and 94 provide amendments to IPC, Indian evidence Act, Bankers book evidence Act, and Reserve Bank of India Act respectively take care of legal validity of electronic evidence. The activities of tampering, eavesdropping impersonation are some, issues that arise during the electronic transaction of documents. All these can be remedied by the use of public key cryptography. However the question of when (time of creation) a document was created or signed electronically still remains unanswered.

This information may be proved to be crucial to be e-commerce legally binding transaction "When?" refers to time stamping. There is need as of now to introduce digital time stamping service in electronic transactions in India and the author has attempted a possible methodology for the same. With the help of DTS, it is possible to guarantee the integrity of electronic record. One can prevent, insider

fraud, prove ownership of intellectual property, or settle disputes with customers, competitors, partners and employees, which are the of vital importance in currently emerging IPR regime.

Real importance of time stamping becomes evidence when there is need for legal use of electronic documents with "long" life time. The time stamping will help in solving the cases where cryptographic scheme used for become unreliable or where the signer have repudiates the signings claiming that he has accidentally lost her/his private key. Although today's time stamping procedure may appear to be complicated, failure e-commerce application are expected to technology.

For last several years, trademark were the poor relation of the intellectual property family, undervalued, and misused by much of the business community. They were treated as second class citizens by intellectual property practitioner and judiciary alike.

Now the time and attitudes have been changed. Business has recognized as the fundamental importance of their brands to present and their future success. Their legal advisors have realized that trademark rights are generally cheap to protect and relatively quick on simple to enforce. The judiciary has now understand that a trade marks is a valuable legal rights that deserves to be treated with the same respect as a patent and copyright. The internationalization of

trade and the growth in advertising since the second world war, have meant that product can now be sold to a global audience. The need to encapsulate complex messages about a product character, quality advantages, in a simple way has therefore increased. Business has found that most elegant summation of these messages is use of a memorable trademarks.

All the values of trademark has grown, so has their abuse by competitors, eager to ride on the back of another's hard earned reputation. However, all form of such competition can damage the reputation and sales of the originator's product. Registered trademark and to lesser extent, their unregistered brethren, are powerful weapon against unfair practices. Recent changes in the trademark laws, in India, and elsewhere, have increased the values of trademark and importance of registration. The importance and value of trademark to our business colleagues and to show how this sometimes arcane area day to day activities. After all, trade that is chosen used and protection correctly, can has forever.

Since the Internet is global phenomenon, experiences has shown that the US has tried to plug the legal lacuna by passing the Trademark Cyber Piracy Prevention Act. There are various steps already a foot to tackle the domain name disputes, especially cyber squatting, on international level. As far as India is concerned, one has

to be pragmatic and it is to be realized that the virtual world of cyber space needs a law for itself. Bringing passing of within the framework of the Trade and Merchandise Marks Act, which is an antiquated legislation (passed in the year 1958) would result in granting trademark holder more extensive protection than what the legislature originally intended. A trend of increased disputes over web address is gaining ground in India over the past few years as companies recognize the commercial potential on the Internet. As companies try to state their claims in cyberspace they often find their prime panels already in the hands of somebody else. The WIPO arbitration and mediation center may order the respondent only to refrain from the use damages for the loss caused to the complainant law are being continuously amended to take care of the technological changes. But it still requires major amendments to deal with challenges posed by the internet and digital revolution. India has already enacted IT Act 2000.

The World Intellectual Property Organization (WIPO), a treaty organization with 171 nations states as member, recently undertook a series of consultations concerning the management of the domain name system. On 30.4.1999 WIPO issued its final report including its recommendations to ICANN. As per its reports, WIPO elected to limit its mandatory general administrative procedure for the resolution of domain name registration (cyber squatting) WIPO also recommended

that the registration agreement contains a provision, for domain on an optional basis, in respect of any dispute in relation to the domain name and such arbitration takes place on live. When one is legitimately entitled to register a domain name, why should be penalized if he seeks to trade in it. Making easy money in itself it not a crime. From the legal angle, it can be contended that a cyber squatting does not deal in any gods and hence, his activities are not likely to cause confusion in the minds of the public.

Suggestions

It is very important to note that the UDRP need to amended to clarify the position relating to the geographical indicators and personal names (that they are beyond the scope of the policy); gripe sites (that criticism is a legitimate interest, and that the concept transment is not suitable for the UDRP) and bad faith (that separate element that the complaint must prove. Further problems, and in particular inconsistent decisions could be avoided if an appeal level was added to the system. It is undisputed fact that UDRP serve an important function to resolve domain name disputes in out of court proceeding that can be implemented on the international basis. The question is whether the process is as fair and effective a it should be and astonishingly, the answer of some what else?

In order to maintain and protect intellectual property it is responsibility upon the legislature to review the Information Technology Act 2002, and the new act take a appropriate step to protect the recent episode of selling of a pornographic MMC clip on the internet portal - which led to the arrest of the chief executive in case of involvement of any who involve in selling pornography.

- Implementation and interpretation of TRIPS provisions for promoting both access to existing medicines and the creation of new medicines.
- TRIPS Agreement should not prevent member governments from protecting public health.
- TRIPS Agreement to be read in light of its objectives and principles.
- International transfer of technology.

The following options can also be considered in the new ordinance:

- The recommendation of Pharmaceutical Research and Development Committee headed by Dr. R.A. Mashelkar, that there is a need to amend section 20 of the Patent Act to make new chemical entity or new medical entity” alone to be patentable.

- The formulation of combinations of drugs, changes in dosage new use, etc., should not be patentable as there is no inventive step involved in it.
- The patenting of microorganism and non-biological processes should be excluded. Similarly in principle, bio-technological inventions should be made patentable.
- Patenting of life-form genes should be specifically excluded. There is no such direct obligation to grant patenting to life forms.
- The terms such as novelty circumstances of national emergency and extreme urgency, and public non commercial use should be defined clearly in the ordinance.
- The working of patents through domestic firms should be made compulsory.
- Right to protect health as a fundamental right.
- Right to grant compulsory licences in the present Act by this measure is rarely invoked in India. In the coming years option should be used if and when needed.
- Sufficient safeguards should be provided against the misuse of compulsory licensing based on any reason whatsoever.

- All compulsory licences should transfer the technology and know-how related to that technology.
- There should be a common policy on patent and Indian pharmaceutical industry.
- The provisions made in the Patents (Amendment) Act, 2002 for parallel imports should be strengthened, as they are insufficient now.
- The Member should be given freedom to establish its own regime in case of the exhaustion of patents and no double royalty should be provided for imports.
- The product patent protection would be applicable from the date of sealing of patent.
- All applications (nearly 5000) kept in the 'mailbox' from 1 January 1995 would fail if the subject matter has been used anywhere in the world prior to 2005. Such a provision is permitted under the TRIPS also. Because article 70(3) of the TRIPS provides that "there shall be no obligation to restore protection to subject matter which on the date of application of this agreement for the Member in question has fallen into the public domain". This provision can be made applicable to the transitional arrangement in India, which is TRIPS compatible.

- It is also necessary to provide more precise definitions and provide more examples for term such as bad faith and legitimate interest.
- It is also necessary to recommended a choice of law provision to guide dispute among complainants and respondent of diverse jurisdictions.
- It is also necessary to provide certain for evidentiary documentation, especially for the common law mark owners.
- It is as necessary to demand advance payments before registration of domain name the cost of the mass domain name speculation.

Bibliography

Books

1. A.K. Koul & U.K. Ahuja (ed.). The law of Intellectual Property Rights: In prospect retrospect, Faculty of Law, University of Delhi, 2001.
2. Alankis - Intellectual Property.
3. Chowdhury, S.K.R. Law of Trademark, Copyright, Patents and Design Volume I 1999.
4. D.P. Mittal - New Law of Trademark passing off and Geographical Indication of Goods.
5. Miller CG, Commercial Exploitation of Intellectual Property.
6. P. Narayanan - Intellectual Property law Eastern Law House - New Delhi.
7. Robert Merkin - Copyright, Designs and Patents: The new Law.
8. S. Venkateswaran; The Law of Trademark and Passing off
9. Vandana Shiva, Afsar H. Jafri et al; Seed of suicide. RFSTE, 2000.
10. Vandana Shiva: &Yoked to Death: Globalisation and Corporate Control of Agriculture, RFSTE, 2001.

11. Vandana Shiva: Stolen Harvest, South and Press, Cambridge, 2001.
12. Vandane, Patents: Myths and reality, penguin Books India, 2001.
13. W.R. Cornish - Intellectual Property. Third Edition, Universal.
14. W.R. Cornish - Intellectual Property: Patents, copyrights, Trademark and Allied Rights, Second Edition.

Article

1. Ashis Kothari, W.T.O., A Right Denied the Hindu Tolico, 50, 2001.
2. B.K. Keayla: TRIPS patent system: Issue for patent (second Amendment) Bill 1999 in A.K. Koul et al (ed.) the law of Intellectual Property Rights: In prospect and retrospect 78, Faculty of Law, Delhi University, 2001.
3. Dyudal Kadir: Columbus and the Ends of the earths, University of California.
4. Z.M. Nomani: Law and Flaws Relating to Conservation of Biological University: A Kaleid Oscopic view, 2000, 2 company of Journal, J 20.

5. Zafar Mahfooz Nomani: WTO TRIPS Agreement and protection of plant variety: Imperative and implication for Indian IPR regime in A.K. Kaulet (Ed.). The law of Intellectual Property Rights: In prospect and retrospect, Faculty of Law, Delhi University, 2001.
6. P.K. Patni: Patent system in India in A.K. Kaul et al (ed.). The law IPR : In prospect and retrospect, 75, Faculty of Law, Delhi University, 2001.
7. Phillippe Calleff: IPR: For an Alternative patent Regime XVI, 21 The Frontline, 1999.

Journals

- Company Law Journal.
- Journal of Intellectual Property Right.
- Chartered Secretary.
- The Journal of Patent Trademark Cases.

News Papers/Magazines

1. Agriculture Today
2. Economic and Political Weekly
3. India Today
4. Out Look

5. The Frontline
6. The Hindu
7. The Hindustan Times
8. The Times of India.

Websites

www.labethis.org/wroldwideleg.html. -89K

www.panos.org.uk/enviornment/gmfoodaid_specialbriefing.htm101k

www.nzfgkgovt.nz/policy law/publication/reports/gemodfoods/99.pdf

www.genecampaign.org/news_folders/CIPR-PRESS/20relese.doc

www.cassavatch.org/current/20articles

www.patentmatics.com/pus.2002/pus47.htm_36k

www.lorwatchindia.org/issue/pid.jsp/articles=744_49K

www.twinside.org.sg/index.htm

www.estd.org/dlgue/2002_04_10/utkarsh.pdf

www.indiatogether.org/environemnt/articles/biodiv.02.htm.

www.rediff.com/news/2001.sept02.patent .html

www.members.tripod.com/israindia/isr/sept 12/vasu.htm

www.financialexpress.com/fe/daily/2000 731/fe031029.htm

www.gewf.com/articles/journal/jil-july99.1.html

www./nominet.org.uk/drs/basic-guide.pdf,m

www.crersolution.ca/servied/and/decisions/0096.htm.